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**In the United States Court of Appeals**

**For The Ninth Circuit**

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No. 18,899

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**TEMPLETON PATENTS, LTD.,**  
*Plaintiff-Appellant,*

v.

**J. R. SIMPLOT COMPANY,**  
*Defendant-Appellee.*

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**APPELLEE'S BRIEF IN NO. 18,899**

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PRINTING ERRORS IN APPELLEE'S BRIEF

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35 USC 102 (b) at pages 52, 53, 18a

35 USC 102 (e) at pages 48, 18a

35 USC 102 (f) at pages 53, 18a

35 USC 135 at page 42

BRIEF

Page 28, in paragraph "(3)", third line:

"pre-cooked" should be pre-cooled

Page 45, fourth line from bottom -

"1949" should be 1950

APPENDIX

Page 6a, fourth line from bottom -

"rools" should be rolls



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Note: Pages in this index designated "a" are appendix pages.



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No. 18,899

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TEMPLETON PATENTS, LTD.,  
*Plaintiff-Appellant,*

v.

J. R. SIMPLOT COMPANY,  
*Defendant-Appellee.*

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## BRIEF FOR APPELLEE

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### I. JURISDICTION

Plaintiff-Appellant (hereinafter termed plaintiff) has appealed from two judgments, each adverse to plaintiff, in two civil actions in the United States District Court for the District of Idaho. As explained in the Prefatory Note, *supra*, this Brief for Defendant-Appellee (hereinafter termed defendant) covers only the appeal in the patent action (Civil Action 3514 below, here No. 18899).

Plaintiff, TEMPLETON PATENTS LTD., is a British corporation engaged in the exploitation and licensing of patents on a world-wide basis, having succeeded to some rights possessed by Farmers'

Marketing and Supply, Ltd., another British corporation, (T-153, 690, 99R 69, DX 15, I 3-21, DX 16, I 23-65).<sup>1</sup>

Defendant is a Nevada corporation with a principal place of business in Boise, Idaho. Defendant has manufactured various forms of processed potatoes and has, at Caldwell, Idaho and at Burley, Idaho, processed potatoes to produce a dehydrated powdered product which goes under various names. (Pretrial order paragraphs 4b and 4c — 99 R 52.)

Plaintiff by its original complaint filed February 24, 1959, accused defendant of infringement of every claim of each of four patents (99 R 3, 4) but by Second Amended Complaint filed October 14, 1959, narrowed its action to alleged infringement of a total of 11 designated claims of three patents [claims 1, 2, 4, 5, 6, 7 and 8 of U.S. Patent 2,119,155 of Faitelowitz, claims 3 and 7 of U.S. Patent 2,352,670 of Volpertas, and claims 16 and 17 of U.S. Patent 2,520,891 of Rivoche] (99 R 8, 9).

Defendant answered, denying infringement of, and denying the validity of, each of the 11 claims in suit and asserted other equitable defenses including estoppel and the laches of plaintiff. Defendant counter-claimed for a declaration of non-infringement and invalidity of the patents in suit (99 R 11-27).

After extensive discovery, numerous stipulations, and full pretrial, the issues were framed by pretrial Order (99 R-50-59) particularly at paragraph 10 thereof (99 R 56, 57) and the action was tried before The Honorable Fred M. Taylor, District Judge, between January 8 and January 30, 1963 (T 1-1654).

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<sup>1</sup> For the convenience of This Court defendant adopts the same system of references to the Reporter's Transcript of Trial Below as well as to citations from the Record in No. 18899 and No. 18900 and of references to plaintiff's and defendant's exhibits, respectively.

The Trial Court rendered a written opinion on March 6, 1963 (99 R 68-94) and on May 24, 1963, made 29 extensive and detailed formal Findings of Fact (99 R 94-114) and Conclusions of Law (99 R 114-116), and entered Final Judgment (99 R 117, 118) in the patent action. On June 20, 1963, plaintiff filed notice of appeal in the patent action (99 R 119).

The District Court had jurisdiction of the subject matter of the patent action pursuant to 28 U.S.C. §1338(a) and the Patent Statutes (35 U.S.C. §§1 et seq., particularly §281 thereof). Venue was proper under 28 U.S.C. §1400(b) since suit was brought where defendant resides. The Trial Court had jurisdiction of the persons of plaintiff (by voluntary appearance) and of defendant (Stipulation and Order, 99 R 30, 31).

The District Court having rendered final judgment dismissing the patent action *in toto* and after trial, This Court has jurisdiction pursuant to 28 U.S.C. §§1291, 1292(a)(4).

## II. STATEMENT OF THE CASE

Plaintiff for its statement of the case in its Main Brief reproduces "and adopts" quotations of selected parts of the Trial Court's Memorandum Opinion. A better statement of these alleged "essential facts" appears in the appendix to this brief where defendant has reproduced the Trial Court's formal Findings of Fact<sup>2</sup> II to XIV inclusive (99 R 96-103)<sup>3</sup> and the remaining FF XV to XXIX (99 R 103 to 114).

This Court holds that where there is conflict between the formal findings and the findings of an opinion, the formal findings must govern.

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<sup>2</sup> Hereafter FF will be used to designate The Trial Court's formal findings.

<sup>3</sup> Emphasis has been employed in this reproduction to show the findings which plaintiff omitted.

*Plastino v. Mills* (CCA 9 1956) 236 F. 2d 32 at 35.

Plaintiff's statement of so-called "essential facts" by no means summarizes the case. More is needed to give This Court a grasp of the case.

#### A. Procedurally and Substantively

Every claim in each of the three patents in suit is directed to a method.<sup>4</sup> This circumstance limits consideration on the issue of infringement to the steps of defendant's processes as compared with the claimed steps of the patented processes to show identity (or when viewed in the light of permissible equivalency of steps). *Englehard Industries, Inc. v. Research Instrumental Corp.* (CCA 9, 1963, 324 F.2d 347); *Celite v. Dicalite* (CCA 9, 1938, 96 F. 2d 242, at 248; cert. den. 326 U.S. 770) and *Moon v. Cabot Shops, Inc.* (CCA 9, 1959, 270 F. 2d 539 at 543).

The Trial Court found as to every one of the seven claims in suit from the *Faitelowitz* patent that there was no infringement by defendant [FF XVI and XVII (99 R 105)] and that there was no equivalency justifying infringement in defendant's processes [FF XVI (99 R 105)]. The District Court did not find, nor did he need to find, anything on the issue of validity of the long expired *Faitelowitz* patent.

Similarly the Trial Court found as to each of the two claims in suit from the *Volpertas* patent that there was no infringement by defendant. He also found on ample evidence (as well as by reason of the acts of Volpertas creating file wrapper estoppel) that there was no equivalency justifying infringement in defendant's processes [FF XXIII at 99 R 110]. The District Court did not find nor did he need to find anything on the issue of validity of the Volpertas Patent which had expired by the time of trial. The court recognized that there were additional differences

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<sup>4</sup> It follows that each of the 11 claims in suit is a method claim.



between defendant's processes and the process *claimed* by Volpertas [FF XXIV (99 R 110)].

The specific findings, and the ultimate findings, of non-infringement and non-equivalency are questions of fact not subject to reversal in the absence of clear error (FRCP Rule 52a); *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U.S. 605, at 609.

The Trial Court found as to each of the two claims in suit from the *Rivoche* patent that the process there sought to be claimed was not inventive and that the claims were invalid [FF XXVII, XXVIII (99 R 111-113)]. The District Court did not find, nor did he need to find, anything on the issue of infringement of the *Rivoche* patent. It follows by operation of law that an invalid claim cannot be infringed.

Determination of the issue of validity probably involves a conclusion of law although the courts have not been unanimous in this view.<sup>5</sup> The best that can be said for plaintiff's appeal is that the ultimate finding of non-infringement disposed of 9 of the 11 claims in suit on findings of fact while only as to the two *Rivoche* claims was the ultimate resolution one of mixed fact and law.

Each of the three patents in suit is based on the activities of a foreigner performed outside of the United States. This brings into operation Sections 104 and 119 of 35 U.S.C. and Section 109 of 35 U.S.C. [Act of August 8, 1946, c. 910 §9, 60 Stat. 943], the provisions of which make inadmissible evidence of knowledge, use or other activity in any foreign country except by proof of filing a foreign application *for the same invention*.<sup>6</sup> Much of the testimony of Mr. Templeton (even apart

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<sup>5</sup> There are some cases, including decisions of This Court, which hold that validity is a question of fact, particularly where the issue is resolved by a finding of *lack of invention*.

<sup>6</sup> See Commentary p. 29, 35 USCA.

from its obvious hearsay character) was inadmissible by statute in this patent action.

The Volpertas patent in suit is, additionally, based on two earlier applications for U.S. Patent filed by him. This brings into operation Section 120 of 35 U.S.C., the provisions of which give an applicant for U.S. Patent the benefit of his earlier, copending U.S. application *for the same invention*.<sup>7</sup>

The Rivoche patent in suit was applied for in reliance upon an Act of Congress which gave, to non-enemy residents of friendly foreign countries, the limited right to file U.S. applications for patent *for the same inventions disclosed in earlier foreign applications*. This limited right was conditioned upon citizenship, lack of evidence of aiding the enemy and lack of enforceability against certain U.S. citizens and parties. The Act arose out of World War II conditions, 35 U.S.C. §101-114, Act of August 8, 1946, c. 910 §§1 to 14, 60 Stat. 943.

The disclosure of the Rivoche patent in suit was extensively and improperly changed between the date of application in 1948 and grant in 1950. This brings into operation the invalidating provisions of Section 132 of 35 U.S.C. which *prohibits* the introduction of *new matter* into the disclosure of the invention.<sup>8</sup>

### B. The Subject Matter of the Patents

The disclosures of each of the three patents in suit related, in more or less detail, to the drying of vegetables which contain starch. Potatoes are mentioned in each patent but none of the three patents (nor any antecedent application) identifies the potatoes as white, red, sweet, or otherwise. 9 of the 11 claims in suit *embrace other vegetables*, as

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<sup>7</sup> See Commentary 35 USCA pp. 29 & 30.

<sup>8</sup> See Commentary 35 USCA p. 37.

well as "potatoes."<sup>9</sup> This is significant by reason of the ancient doctrine that *what infringes if later anticipates if earlier*. The relevant prior art is much enlarged.

Throughout the trial and in its post-trial and appellate briefs, plaintiff characterizes the subject matter of the patents in suit as the "F-V-R inventions" as though all three patents were somehow merged into an "all for one, one for all" venture. This characterization is refuted by Templeton who admitted that the several methods of the patents were mutually exclusive (T 650-653, 783-789).

The inherently mutually exclusive nature of the three processes in suit was further admitted by Templeton who said (T 231) that the processes of the three patents were:

[Faitelowitz] *"dry it down to this level";*

[Volpertas] *"Suck it out to that level";* and

[Rivoche] *"'Squeeze it out' which required a step of freezing before squeezing."*

Again talking about the patented processes, Templeton described them as (T 875):

*pre-drying by heat,  
pre-drying by add-back, and  
pre-drying by freezing and thawing.*

### III. THE "QUESTIONS" FOR DECISION RESTATED

Plaintiff's Main Brief at page 9 specifies the questions to be decided in the form of three negative contentions, not one of which is

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<sup>9</sup> Only claims 3 and 7 of Volpertas are limited to potatoes — but note claims 1 and 2 thereof at PX 2 — I-43.

more than one and one-half lines long. The errors are stated baldly to be in finding non-infringement of two of the patents in suit and invalidity of the third one.

Rule 18-2(d) of This Court seems to require much more specificity than Plaintiff has shown in stating the questions for decision. In compliance with the spirit of Rule 18-3, defendant restates the questions as follows:

### A

*As to the Faitelowitz patent*, the question is not whether the Trial Court's findings of non-infringement of claims 1, 2, 4, 5, 6, 7 and 8 were "clearly erroneous" but whether the Trial Court could have made any other finding in the face of Templeton's admissions: *that the Faitelowitz method had never been used anywhere in the world* (T 564) and that he (Templeton) did not find evidence of the Faitelowitz method in defendant's commercial operation (T 788).

### B

*As to the Volpertas patent* the question is not whether the Trial Court's findings of non-infringement of claims 3 and 7 were "clearly erroneous" but whether the Trial Court could have made any other finding in the face of Volpertas' voluntary surrender of broad add-back claims in his abandoned application [PX 2 -I 100 to 150 particularly at 103, 106-107 and 112-113] and Volpertas' presentation and acceptance of claims which are as patently limited as those of the patent (PX 2), particularly in view of the state of the art (DX 17).

### C

*As to the Rivoche patent*, the first question is not whether the Trial Court's conclusion of invalidity of claims 16 and 17 by reason of lack of invention is sustainable but whether the Trial Court could reach any other conclusion in the face of prior patents (DX 17) including the

antedating U.S. and foreign patents of Faitelowitz and Volpertas (DX-17, PX 1 and PX 2), particularly in the light of Templeton's admission that what *Rivoche* did was to *cut off the top of the moisture range of Volpertas and Faitelowitz* (T 231, 232).<sup>10</sup>

#### D

*As to the Rivoche patent*, a further question is whether either of claims 16 and 17 thereof can be found to be valid in the face of *Rivoche's* failure to disclose the subject matter thereof in either of his 1939 British patent applications (PX3, II 50 to 63 and PX3, II 35 to 49) or until his 1948 application for U.S. Patent was pending (PX2, I 12 to 30), particularly in view of the antedating or intervening prior art (DX 17) and extensive changes in the 1948 application (PX2, I 12 to 30 and 65 to 97).

### IV. ARGUMENT

#### A. What Happened at the Trial and the Result

The trial lasted over three weeks.

For plaintiff, plaintiff's owner Robert A. S. Templeton testified during the case in chief and on rebuttal. Two U.S. Department of Agriculture employees, Olson and Harrington, testified by deposition as experts for plaintiff.<sup>11</sup> One Glabe testified as an expert on microscopic readings. For defendant, Kueneman<sup>12</sup> and Conrad testified as fact witnesses and gave expert testimony. Dr. Jackson, an independent engineer of high qualifications gave expert testimony for defendant.

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<sup>10</sup> And, inherently, unlawfully *re-monopolize the bottoms of the moisture ranges of the prior patents of Volpertas and Faitelowitz*.

<sup>11</sup> The Olson and Harrington Testimony destroyed plaintiff's case for infringement of Volpertas.

<sup>12</sup> Defendant's director of Research and a life-long expert in the drying and preserving of foods (T39, 139; DX 26, II-38).

Templeton testified in the multiple roles of proprietor, historical narrator, self-appointed expert and, at times, oracle. The nature of his testimony was such as led the District Court to observe as to Templeton:

*"I have suspected all through the testimony that he is very, very much interested in the outcome of the litigation. I don't think there is a doubt about it."* (T 450)

and

"Q I take it that you recommend equilibration during their delay between the completion of the drying and the grating or the crushing?

"A Yes. If I may ---"

MR. BEALE: Objection, Your Honor, I don't think that is an interpretation of the patent. It's a recommendation of what he is doing.

THE COURT: *Yes, I don't know whether he is talking about this patent, what he would do then or what he would do now."* (T 215-216.)

As part of plaintiff's case, Templeton put on a laboratory *inter partes* demonstration before the Trial Court. This demonstration was performed to show the Faitelowitz and Volpertas *processes*. (T 235-251, 309-311, 327-357.)

As part of defendant's case, Kueneman and Conrad put on an *inter partes* demonstration in defendant's pilot plant in Caldwell, Idaho. This demonstration was performed to show that defendant's processes did not conform to at least two of the limitations expressed in claims 3 and 7 of the Volpertas patent. *Defendant has not pre-dried potato pieces "in the absence of mechanical pressure" and has not finally dried a*

moist powder *under "moderate" heat and "in vacuo."* (DX 47A and 47B; Vol. III 157-193.) The Trial Court was invited to (T 954), but did not attend this Caldwell demonstration. The demonstration was preserved as an agreed statement (DX 47a) and photographs (DX 47b).

The entire conduct of the trial supports and strengthens the District Court's formal findings in this action for the same sound reasons stated by The Supreme Court.

"Rule 52(a) of the Federal Rules of Civil Procedure, 28 U.S.C.A., provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witness.' *To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues.*

*"The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."* (Emphasis added.)

*Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271 at 274, 275; 69 S.Ct. 535, at 537, 538.

## V. ARGUMENT AS TO FAITELOWITZ

### A. The Faitelowitz Patent Is Admittedly Not Infringed

In the conventional patent infringement suit there is usually some doubt about the fact of infringement. Here, as to the Faitelowitz patent, there is no doubt. Templeton admitted non-infringement by defendant.

Testifying as a practical man with extensive knowledge of the art of drying foods including vegetables, fruits and meats (T 159, 480, 481) Templeton stated (T 204)

"Q. Will you look at Plaintiff's Exhibit No. 1, which the" [sic] "Faitelowitz patent in suit and explanatory papers, look at Faitelowitz patent in suit --

A. Yes.

Q. Are you familiar with that as a document?

A. Yes, I am.

Q. In your factories in England, do you now practice what you consider to be the significant disclosure of that document?

A. *We practice the principle, but we do not use the method he advocates here.*<sup>13</sup>

Q. What is the principle as you understand it?

A. The principle is that the cells -- the potato cells, with- in which are enclosed the starch grains, may, after cooking, be separated without injury to the membrane of the cells after a partial drying and before final drying."

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<sup>13</sup> All italics appearing herein in quoted testimony have been added for emphasis.



Templeton further testified on direct examination (T 221)

"Q. *Even with equilibration, would you find a sequence of steps that you have described to us as the way of carrying out the Faitelowitz invention in the laboratory a desirable process for carrying out commercially?*

A. *No, sir. I would say that it is desirable to carry out commercially until there may be found some better way of reaching this principle.*

Q. *Do you know such a better way?*

A. *Yes, I do.*

Q. *What is that?*

A. *The way proposed by the co-worker, Volpertas."*

On cross examination (T 564) Templeton testified:

"Q. *My colleagues tell me that earlier last week during your direct examination they understood you to say that you knew of no establishment anywhere in the world where the Faitelowitz principle was used commercially?*

A. *That is true.*

Q. *That includes the United States?*

A. *That includes the United States. If you say the method, not the principle. I think each one, as I have testified, uses the principle.*

Q. *I am talking of his method.*

A. *The method of cutting to small pieces and getting to pre-drying range has never been used in any country to my knowledge.*

Q. *And that is<sup>14</sup> the plant of the Defendant?*

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<sup>14</sup> Defendant believes the word "is" is an error in reporting and that the question actually commenced "And that includes \* \* \*." This would be consistent with the preceding questions.

A. That is, to the best of my knowledge.

Q. *You find nothing of his method on that chart, Exhibit No. 6?*

A. *Yes."*

Also on cross examination, (T 806, 807) Templeton said:

"Q. *Did you explain to Mr. Scott or Potato Products Company on or about July 26, 1950, your view that patent 2,199,155 is unusable commercially?*

A. *Yes.*

Q. *What did you mean by the explanation?*

A. *If one was starting out fresh to acquire a new plant, one would go to the add-back principle on a question of operating cost per pound."*

Templeton, on cross examination (T 786) was asked questions concerning whether or not "proposals" of the patents in suit were mutually exclusive and he gave the following answers to the following questions:

"Q. *Are there any others in the range of the F.V.R. that you can perform without performing the other?*

A. *Yes, there are.*

Q. *Will you enumerate them?*

A. *Well, starting at the beginning you can work Faitelowitz on his own without any assistance from his co-worker Volpert.*

Q. *You would not use any of the rest of the proposals?*

A. *No, you could do it by himself."*

At Tr. page 788 Templeton gave the following answers to the following questions:

"Q. It's Plaintiff's Exhibit 5, the right-up.<sup>15</sup> I don't want you to answer any of these questions 'in vacuo'. I will start off, Plaintiff's Exhibit No. 6, the flow-sheet, and Plaintiff's Exhibit No. 5 which has the chart in it, and as best you can, I want you to bear in mind Mr. Kueneman's testimony that you heard, and I shall ask you, first, *in all of that information do you find any indication to you that the Defendant had ever used in any commercial operation the freeze-squeeze principle of Rivoche wherein the moisture was mechanically removed by a centrifuge?*

A. No.

Q. Did you find any evidence that the freeze-squeeze principle of Rivoche was used for the removal of the moisture by an absorbent roll?

A. No.

Q. *And you have told us that you have not found anything of the Faitelowitz method?*

A. Principle, yes. *Method, no."*

**B. Merely Comparing Defendant's Processes  
(Shown In PX 5 and PX 6) With  
Faitelowitz' Claims Shows  
Non-Infringement**

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Templeton's admissions, quoted *supra*, of defendant's non-use of the Faitelowitz process, alone provide sufficient evidence to support the Trial Court's findings of non-infringement of the Faitelowitz patent.

Equally sufficient evidence of non-infringement is provided by the claims in suit as compared to defendant's processes illustrated in PX 5 and PX 6. (II 130 to 183)

To assist The Court defendant has reproduced the Faitelowitz claims in suit in the Appendix to this brief at page 38a thereof. A "Pull-out" appendix page has been used to permit comparison with the description of defendant's processes at pages 25 to 28 *infra*.

<sup>15</sup> Obviously "write-up."

The emphasized portions of the claims reproduced in the Appendix have no counterparts in defendant's processes.<sup>16</sup> Faitelowitz' claims 2, 4, 5, 6, 7, and 8, are specifically dependent upon claim 1 and incorporate by reference all language thereof. Plaintiff's Main Brief has made no effort to apply these *dependent* claims to defendant's processes and only a half-hearted effort to do so as to claim 1 itself.

The controlling principle of law is stated in This Court's decision in Engelhard Industries, Inc. v. Research Instrumental Corp. (CCA 9 decided October 28, 1963; 324 F.2d 347 at 351, 139 U.S. PQ 179 at 183.

*"A patent for a method or process claim is not infringed unless all of the steps or stages of the process are used [Royal v. Coupe, 146 U.S. 524 (1892); Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222 (1880)], and a patent for an apparatus is not infringed unless the accused device is a copy of the claimed apparatus either without variation, or with such variations as are consistent with its being in substance the same thing. Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42, 3 USPQ 40, 44 (1929) quoting from, Burr v. Duryee, 68 U.S. (1 Wall.) 531, 573 (1863)."* (Emphasis added)

### **C. The Faitelowitz Patent Does Not Disclose or Protect the "Principle" Ascribed To It**

In an effort (doubtless born of desperation) to sustain this patent Templeton purports to find in Faitelowitz a broad principle. The alleged principle (quoted *supra* at page 12) is that *"the potato cells within which are enclosed the starch grains may, after cooking, be separated without injury to the membrane of the cells after a partial drying and before final drying."*

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<sup>16</sup> Defendant in Appendix pages 39a and 40a has reproduced the Volpertas claims and the Rivoche claims in the same manner and for the same purpose.

One answer to plaintiff's contention for a "principle" is that the Faitelowitz patent, on its face, *fails to reveal separation of cells* and fails even to reveal "potato cells within which are enclosed the starch grains." But another answer is that Templeton admitted as much:

"Q. You were asked several questions this morning with regard to the Faitelowitz patent; one of the questions related to the preservation of the potato cells. *Do you find any teaching in the Faitelowitz patent in suit which makes any reference to potato cells, and if so, I wish you would point it out.*

A. *I don't think he does use that terminology.*" (T 1608)

Another answer to plaintiff's "Faitelowitz principle" contention is that process patents are not granted on broad principles (even if disclosed). The Trial Court properly followed This Court's ruling in *Kemart Corp. v. Printing Arts Research Laboratories* (CCA 9 1953, 201 F.2d 624, at 632).

*"It might be said that both processes rely upon the broad principle that by proper use of a particular kind of light in connection with a particular type of copy the dots in the highlights of a halftone negative may be photographically eliminated without affecting the tone areas. But Marx was given a patent for a process; he did not, and could not, patent a principle."*

The *Kemart v. Printing Arts* doctrine is but another way of ruling that *there is no heart or gist* of an "invention." This Court so held in *Nelson v. Batson* (CCA 9 1963, 322 F.2d 132 at 137):

"We can only answer, 'that there is no legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent.' [citing] *Entron of Maryland, Inc. v. Jerrold Electronics Corp.*, 295 F.2d 670, 677 (4th Cir. 1961) quoting *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345, 81 S.Ct. 599, 5 L.Ed. 592 (1961)."

**D. The "Paper Patent" Of Faitelowitz Is Not Entitled To Broad Construction**

**1. By "law principle" and by admission.**

Before the District Court plaintiff made no effort, during trial or in its post-trial briefs, to apply any of the Faitelowitz claims in suit to defendant's processes or to point out any equivalent steps therein (FF XVI 99 R 104). In its Main Brief plaintiff makes a limited effort to apply claim 1 only. Plaintiff relies on equivalency and uses all of the well-worn arguments.

Faitelowitz is asserted to be a "pioneer," "generic" patent which created a new industry for which the U.S. public and Idaho potato farmers in particular are much indebted. The assertion simply does not stand up.

It should not be necessary to observe that raw potatoes are still sold in quantity in this country to housewives who still prefer to cook their own vegetables; nor to note that "potato chips," pre-cooked frozen "french-fried" and many other forms of packaged processed potatoes are available in most urban and rural food stores in our country.

The Court needs only to look at the flow sheets of defendant's processes (PX 5, II 140-143 and PX 6, II, 181-183). As shown thereon defendant alone made "specialized starch," "whole frozen baked potatoes," "canned whole potatoes," "frozen scalloped potatoes," "flour and meal," "loose frozen, shredded, mashed, stuffed" potatoes, "frozen 'french fried' potatoes," "diced potatoes for dehydration or freezing," "frozen hashed brown or patties." None of these products has any relevancy to the patents in suit—certainly the U.S. public and Idaho potato farmers are not indebted to plaintiff for them and certainly mashed potato powder is but a small segment of the potato industry.

This Court stated in *Cocks v. Rip Van Winkle Wall Bed Co.*, (CCA 9 - 1928; 28 F.2d 921, at 922):

*"Another reason why the appellant's combination should not receive the construction due to a pioneer invention, but, on the other hand, should be strictly construed, is the fact that although the invention has been patented nearly ten years<sup>17</sup> before the present suit was begun, it had not been utilized or placed upon the market but was still a paper patent."* (Emphasis added.)

Here, there is also a cogent admission in a June 10, 1949 letter by plaintiff's counsel to defendant's patent counsel; (PX 8-III 110):

*"In the third paragraph of that letter it is stated that it was your opinion that the Volpertas and Faitelowitz patents are not basic patents. I think I could agree with that statement, whatever the meaning given to the much used and abused word 'basic.' The two patents cannot be 'basic' patents under any definition of the word which I think can be accepted."*

## 2. Because of prior art.

Templeton gave credit to Faitelowitz as the first to observe potato cells under a microscope, as the first to make unruptured dried cells or granules, and as the first to describe a process of drying in two stages while stopping in the middle. Every one of these "firsts" was old in the prior art.

The 1898 *Neuman* patent cooked potatoes, let them cool, mashed the cold potatoes, let the cold mash stand for an hour, reduced this product to small particles or *granules* and desiccated or dried this product which was yellow and made an edible product. (DX 17, I 75) Templeton said this was a useless process--but then so was Faitelowitz'.

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<sup>17</sup> Here 21 years at commencement of suit and 24 years when Templeton testified at the trial.

Templeton criticized the process because of pre-treatment with sulfite (which defendant uses in its processes) and reference to "slimes" (which defendant obtains in its lye peeling steps).

The 1912 *Cooke* patent described a cooked, shredded, dried, potato product having *unruptured potato cells*. (DX 17, I 78, 79.) Cooke describes cooking, dividing the potatoes, while cooled by air at 30<sup>o</sup> to 100<sup>o</sup> F. then shredding *or otherwise more finely dividing* the predried product which is then dehydrated by hot air at 100<sup>o</sup> to 180<sup>o</sup> F. Cooke warns against grinding or crushing as this would rupture the cell walls which enclose the starch cells or granules. Claim 6 of this 50-year old Cooke patent reads:

"[6] As a new article of manufacture, *dehydrated finely divided potatoes having the cell walls of substantially all of the cells enclosing the starch granules intact.*"

The 1926 *Heimerdinger* patent cooks potatoes, rices them, while hot, through a screen, and spray dries the screened particles to produce *"very fine whitish particles or granules."* (DX 17, I 89.)

The *"Scientific American"* published, in 1932, described an Idaho process of spray drying potatoes to produce a powder; the article describes how the particles looked under a microscope--"tiny round particles appearing under the microscope much like puffed grains of wheat." (PX 11, III 281.)

*Thorpe's Dictionary of Applied Chemistry* (1929 Ed.) (DX 17 I 213-223) published in much detail the properties of different sources of vegetable starches including the amounts present, the measured granule sizes and the various temperatures at which different starches gelatinize.

*The art prior to him shows that Faitelowitz was a latecomer in a long line of investigators who had patented or published detailed information of the nature of vegetable cells, the nature of starch grains, drying temperatures, gelatinization temperatures, methods of separating vegetable cells and producing dehydrated vegetable granules,*



*including expressly potato granules. There was and is nothing pioneer or basic about Faitelowitz.*

Plaintiff argues that this antecedent art is valueless because (so *Templeton* says) none of it succeeded in putting a dehydrated potato powder on the market--but Faitelowitz had not succeeded even after twenty-five years.

### 3. Because of fatal indefiniteness.

This Court aptly described the Faitelowitz patent in two of its earlier decisions. In *Kruger v. Whitehead* (CCA 9 1946, 153 F.2d 238 at 239), This Court said:

"The patent does not inform persons familiar with the art how to utilize the patent. They are left to make their own selection of material and their own experiments to practice the invention. Complete disclosure is the price paid for the patent's temporary monopoly. The truth is that all the patentee had was an idea that the use of a solvent ink on an identification card would tend to prevent counterfeiting. *Mere ideas are not patentable; it is the means for carrying the idea out that is patentable.*" (Emphasis added.)

It is difficult to find more apt language than the above unless we read *Craftint Mfg. Co. v. Baker* (CCA 9 1938, 94 F.2d 369 at 373) where This Court said:

"**This is not a disclosure of a process, but a mere suggestion of a process not disclosed.**" [citing cases] (Emphasis added.)

Both the disclosure and claim 1 of Faitelowitz *embrace* potatoes and other "*starch containing vegetables.*" Templeton testified (T 1633):

"Q. *Isn't starch containing the same as farinaceous as you have used it?*

A. I am a little doubtful on that, Mr. Beale, because *in this proposal* [Faitelowitz] *he enlarges the*

*scope, or tries to, very considerably, and he alters the starch containing--now, starch containing could embrace products which would not qualify as farinaceous. I think there are not many things that don't contain starch, other than meat."*

At the threshold the patent is fatally broad in subject matter. It does give one example of cooking whole potatoes and gives a cooking temperature. It is impossible to determine conclusively whether the cooking temperature is the temperature of the potatoes or of the environment in which the potatoes were cooked.<sup>18</sup>

All other temperatures are merely stated as the upper limits of an undisclosed temperature range. *Nowhere does the patent supply any temperature at which any drying is performed.*

The patent gives (at page 1 column 1 lines 44, 45) a direction to *pre-dry potato pieces "until they have lost at the most about 60% by weight of their initial water content."* This is the maximum water loss, not a clear expression of a range of moisture loss. Claim 1 of the patent has the same maximum limitation. But the patent also gives (at page 1 column 2 lines 49, 50) a conflicting direction to pre-dry the pieces until a "stage is usually reached when *the potatoes have lost about 50 to 60% in weight calculated on the initial weight of the raw potatoes.* Claim 4 in suit superimposes this same moisture loss on the lesser moisture loss of claim 1.<sup>19</sup>

The two directions for the removal of water from potato pieces (before "crushing or grating" them)<sup>20</sup> are in direct conflict and cannot

<sup>18</sup> This same doubt exists as to every other temperature mentioned in the patent.

<sup>19</sup> Defendant submits that a percentage of the water content is obviously less than the same percentage of the whole potato, which contains solids plus water.

<sup>20</sup> Defendant mashes before removing water, contrary to the "essential" requirement of Faitelowitz that the reverse order be followed (PX 1, I 6, col. 1, lines 29-34).

be reconciled. Templeton resolved the conflict by ignoring the direction of column 1 of the patent and adopting the direction of column 2 of the patent. This is convenient but it hardly explains away the circumstance that the moisture removal limitation in the description (which Templeton ignores) is the same moisture removal limitation which is incorporated in claim 1 in suit (and by reference in every other Faitelowitz claim in suit).

The manifest uncertainties and conflicts of directions apparent on the face of this patent and in the claims in suit are repugnant to the requirements of 35 USC §112. The Trial Court did not find Faitelowitz to be invalid (although he might properly have done so). Defendant does not contend for a mandate of invalidity respecting Faitelowitz (in the absence of any findings thereon by the Trial Court).

Defendant does contend that any patent (and any patent claims such as Faitelowitz') which ignores the statutory requirements of definiteness should be strictly construed and given no range of equivalents. The Supreme Court has ruled:

"Certainly if we are to be consistent with Revised Statute Section 4888, *a patentee cannot obtain greater coverage by failing to describe his invention, than by describing it as the statute commands.*" *Halliburton Oil v. Walker*, 329 U.S. 1 at 13; 67 S.Ct. 6 (emphasis added).

and

"The claim is a statutory requirement prescribed for the very purpose of making the patentee *define precisely* what his invention is; and it is *unjust to the public*, as well as an evasion of the law, *to construe it in a manner different from the plain import of its terms.*" *White v. Dunbar*, 119 U.S. 47 at 52 (emphasis added.)

**E. The District Court Committed No Error In Finding That Faitelowitz Was Not Infringed**

The Trial Court's findings (FF XVI and XVII--99 R 104, 105) that defendant had not infringed any of the Faitelowitz claims in suit and that Faitelowitz was not entitled to any range of equivalency were fully supported by the evidence and were based on sound decisions of This Court and of The Supreme Court. There is ample further evidence of non-infringement in addition to that particularized by the District Court. There is no "clear error" as to this patent.

**VI. ARGUMENT AS TO VOLPERTAS**

**A. The Volpertas Patent Was Correctly Construed in Accord With Fundamental Principles of Law**

This Court's recent decision in *Engelhard v. Research Instrument, supra*, recognized that method or process claims are not infringed unless all of the steps or stages of the process are used. Where the doctrine of equivalents is invoked, This Court has said in *Moon v. Cabot Shops, Inc.*, (CCA 9, 1959, 270 F.2d 539 at 543):

"[6, 7] The doctrine of equivalents gives to a patentee the benefit of his monopoly in every form in which it may be copied in the absence of manifest disclaimer, *but the range of equivalents can in no event be more than commensurate with the scope of the patentee's invention.* Etten v. Kauffman, 3 Cir., 121 F.2d 137, 140. In determining the permissible range of equivalents, *the court must consider the state of the prior art, the novelty and contribution of the claimed invention, the nature and extent of the differences between the patented and the accused devices, the scope of the claim of the patent and*

*the limitations in it, and other surrounding circumstances. Long Mfg. Co. v. Holliday, 4 Cir., 246 F.2d 95, 100.*" (Emphasis added)

\* \* \* \* \*

"[8, 9] It thus becomes necessary for us to analyze and construe the claims of the patent. In doing so, we are mindful of certain well-established rules of construction. *Claims of a patent must be construed not only in the light of the specifications and drawings, but also with reference to the file wrapper history. White-man v. Mathews, 9 Cir., 216 F.2d 712, 715. That is, the claims of the patent must always be explained by and read in connection with the specifications and in the light of definitions and admissions made by the applicant in the proceedings in the Patent Office. Westinghouse Electric Corp. v. Hanovia Chemical & Mfg. Co., 3 Cir., 179 F.2d 293, 296-297. And a claim must be read and interpreted with reference to claims which have been rejected. Claims which have been allowed cannot, by construction, be read to cover what has been thus eliminated from the patent. Hall v. Wright, 9 Cir., 240 F.2d 787, 794.*" (Emphasis added)

The Trial Court correctly followed and applied these "law principles" in his findings.

## **B. Defendant's Processes, Which Were Fully Revealed, Show No Infringement of Volpertas**

### **1. By Mere Inspection of Defendant's Processes**

In its manufacture of dehydrated potato granules, defendant has used white potatoes grown in Idaho. We emphasize this because not one of the three patents in suit identifies the "potatoes." Defendant's process, except for the initial production in 1950-1951, has been essentially a

continuous process in which the raw potatoes travel progressively through the line and are operated upon at various stages of the process in a continuous manner to form a continuous stream of finished product. We emphasize this because Volpertas (indeed each of the three patents in suit) obviously contemplates a batch process, in which the various operations of the process are performed on a limited amount of vegetables which are cooked as a batch, and processed as a batch, to produce a batch of finished product.<sup>21</sup>

There have been progressive changes and improvements in defendant's processes (T 77-79, 88-91, 98, 116, 387-401). Most of the steps of defendant's processes are shown on PX 6 (PX I-181 - 183) and shown and explained in PX 5 (PX I 130-180) and PX 14 (PX III 328, 329). Plaintiff seems to place most emphasis on PX 6 so we shall describe defendant's processes illustrated thereon, using italics to emphasize the points of difference between Volpertas' claims 3 and 7 and defendant's commercial processes.

PX 6 shows that the raw potatoes are peeled by a caustic or lye peeler, then washed, then conveyed to an inspection station where the potatoes are trimmed of bad spots. Then the potatoes are graded in size and, depending upon the size, may or may not be sliced. The sliced or graded potatoes are *washed to remove free starch* and then are steam cooked. A water cooking step has been used since about 1954, which changes the potato physically and chemically (T 77-79). The cooked whole potatoes or slices are *then conveyed directly to a pair of mashing rolls in which the potato pieces are mashed while quite hot. The hot mashed potatoes are then conveyed to mixers and are mixed with dried potato granules* (variously termed "seed" or "add-back"). *From the*

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<sup>21</sup> Volpertas mentions "continuous" but periodic additions or withdrawals from a hermetically sealed vacuum cylinder is *discontinuous or batch*.

*mixers the mixed mash and seed (referred to on PX 6 as "a moist granulated product" having a moisture content of 35 to 38%) is conveyed to equalizing bins and from the equalizing bins the moist product is conveyed to pneumatic driers, which discharge into a cyclone collector from which a product is continuously discharged. This product which has a moisture content of 12% to 14% is then sifted to size grade it, part of it returned as seed or add-back and another part of it is further dried in bone driers to produce the finished product of approximately 6% to 7% moisture.*

At about 1955-1956 the *mashing rolls* (shown under the numeral "2" on PX 6) were removed and *replaced with a pug-mill in which the cooked potato pieces were simultaneously mashed, while hot, in the presence of the seed or add back material* (T 86, 88, 89).

The various *temperatures* of defendant's potatoes *at the time they were mashed in the mashing rolls were in the range of 140° F. to 180° F. and preferably 160° F. to 170° F.* (PX 5, II 156) (T 83). These temperatures were slightly lower than the temperatures of the potatoes, or potato pieces, as they emerged from the cooker in defendant's process. *When defendant used the pug-mills, the potatoes were charged directly to the pug-mill at temperatures of 170° to 205° F. without any cooling* (PX 5, II 156).

The evidence upon which the foregoing condensation of defendant's processes is based is sufficient to show that at all times between the commencement of defendant's processes in 1950 and the Trial, the following is true:

*Defendant (1) cooked potato pieces, (2) mashed the potato pieces while hot, (3) predried the mashed potatoes while hot<sup>22</sup> by admixture with dried potato product (this pre-drying was performed without added heat from any source*

<sup>22</sup> In defendant's pug-mill operation after 1957 defendant mashed and mixed the potato pieces with the dried product while hot.

and was carried out to a point where the admixture contained from 30 to 40% moisture) *and* (4) thereafter *dried the admixture by atmospheric drying.*

## 2. By comparison with claims 3 and 7 in suit

To emphasize the non-infringing differences between defendant's process and the Volpertas' claims in suit, defendant has reproduced them in the Appendix hereto using bold-face type to show the *non-infringed* steps of the *claimed* process.

The language of each claim unmistakably requires the following sequence of steps:

- (1) pre-dry *the potato pieces* (the same pieces that were initially cooked) *in the absence of mechanical pressure thereon* (on the pieces) *until the initial weight of the potato mass* ("mass" has no antecedent except cooked potato pieces) *has been reduced by about one-half;*
- (2) *then cooling the potato mass* (the cooked potato pieces of reduced weight);
- (3) *then mechanically converting the same into a moist powder* (mechanically mashing the pre-cooked, pre-dried and pre-cooked potato pieces);
- (4) *then finally drying the moist powder* (formed from pre-cooked, pre-dried, pre-cooled and then mashed potato pieces) *under moderate heat and in vacuo* (in a hermetically sealed vacuum dryer).<sup>23</sup>

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<sup>23</sup> Claim 3 additionally specifies that *the pieces* be cooled to 10° C. (50° F.) while claim 7 additionally requires that several *batches* of product be collected for final drying. Neither of these steps is to be found in defendant's continuous processes.



Comparison of these claims with defendant's processes emphasizes the correctness of the Trial Court's finding of non-infringement.

**3. By the clear language of the patent disclosure.**

The language of the Volpertas patent itself makes the best argument in support of the Trial Court's findings that, in the Volpertas process claimed in claims 3 and 7 thereof, the predrying is to be accomplished by heat (FF XX-99 R 108). It states (PX 2, I-41):

"According to the present invention *predrying is resorted to under heat and without agitation* to reduce the water content of the potatoes to extent such as to permit the subsequent drying operation to be performed under heat and vigorous agitation \* \* \*." (Col. 1 lines 34-39)

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*"The potato pieces are now predried preparatory to subdividing them into moist powder. This predrying operation is carried on until the potato mass has been reduced to about one-half its initial weight by loss of water. In this pre-drying operation it is important to avoid excessive agitation or pressure upon the potatoes. Subject to this precaution the predrying may be conducted under controlled heat preferably though not necessarily, with the application of vacuum."* (Col. 2 lines 33-43)

On page 2 of the patent (PX 2, I 42) it states:

*"Alternatively the cooked potato pieces may be predried without vacuum preparatory to reducing the same to the moist powder. In such operation they are desirably laid in a suitable dryer through which is passed a current of air, not necessarily completely dried air, which is heated to desirably about 50<sup>0</sup> C." [132<sup>0</sup> F.] "During such pre-drying operation, the potatoes*

are frequently or constantly moved, but *not subjected to mechanical pressure*. After the predrying treatment cooling may be effected in the same dryer by passing cool instead of warm air therethrough.

"The step following the pre-drying above set forth, whether performed with or without vacuum, is mechanically to convert the mass into a moist powder. Before this is done, it is desirable to cool the same down further as by exposure to the open air, if the climate is sufficiently cold or by pre-chilled air, at a temperature preferably not higher than 10°C.<sup>24</sup> the mass may be subjected to mechanical pressure to convert it to a light moist powder without rendering it pasty." (Col. 1, lines 14-36.)

It further states:

"The moist powder is now subjected to the final drying operation, desirably in the same cylinder used in the predrying. This operation is desirably conducted under moderate heat, desirably at about 30°C.<sup>25</sup> under vacuum and with vigorous stirring \* \* \* preferably until the powder has only about 12 to 15 per cent of water content." (Col. 1, lines 61-69)

The identity of the process claimed in claims 3 and 7 of Volpertas with the process described in the illustrative example quoted above is readily apparent. The differences between Volpertas' illustrative example and defendant's processes are also self-evident.

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<sup>24</sup> 10°C. is 50° F.

<sup>25</sup> 30°C. is 84° F.

## C. Claims 3 and 7 of Volpertas Must Be Strictly Construed

### 1. Because of file wrapper estoppel

Here, as with Faitelowitz, plaintiff seeks to ignore the plain import of the claims and to stretch them beyond their clear meaning by invoking the doctrine of equivalents. In essence *plaintiff contends that heat drying potato pieces, in the absence of mechanical pressure, until the pieces have lost fifty per cent in weight, then cooling the pieces, then mashing the cooled pieces, is the same as mashing the pieces while hot [without additional heating] and mixing the hot mash with dried potato powder, i.e. the add-back step.*

Unfortunately for plaintiff the history of the Volpertas patent and the wholesome doctrine of file wrapper estoppel combine to destroy plaintiff's case. The Trial Court correctly so found.

The Volpertas patent was based in part on each of two earlier Volpertas applications. For convenience the parties have designated the two earlier Volpertas cases as V-1 and V-2, respectively, and the patented case as V-3. As is apparent *in the V-2 case Volpertas therein presented and relinquished claims which unmistakably and unrestrictedly were drawn to the add-back step.*

Plaintiff's contention of equivalency is squarely opposed by the rule:

"Claims which have been allowed cannot by construction, be read to cover what has thus been eliminated from the patent." *Moon v. Cabot Shops, Inc.*, *supra* at 543, citing *Hall v. Wright* (CCA 9) 240 F.2d 787, at 794.

#### (a) By the "V-1" application

In October, 1937, Volpert filed a British application (DX 17, I-152) which was the antecedent of his U. S. application 234,261 (PX 2, I 46-55).

This U. S. application involved a process for forming a dry powder from farinaceous vegetables by drying the vegetables in illustrative drying apparatus at a temperature of about 50<sup>0</sup> C. The treated material was subjected during *predrying* to a *thorough crushing*, disintegrating, scraping and stirring action. The claims so stated (PX 2, I-53).

The apparatus to permit the treatment of the vegetables in the foregoing manner was illustrated at PX 2, I-55. It is very clear that the disclosure of this application required the *predrying of potatoes by the application of mechanical pressure* imparted to potatoes by the rolling and crushing element. During the prosecution of this application the applicant's attorney emphasized the importance of *crushing by pressure* in accordance with the teaching of this application (PX 2, I'60, 62-64).

Eventually every claim in this Volpert application was "finally rejected" and an appeal was taken to the Board of Appeals of the U. S. Patent Office (PX 2, I'71, 72). The viewpoint of the Patent Office in refusing a patent on this application was fairly expressed in the Examiner's statement at PX 2, I-74.

In due course, on or about December 28, 1942, the Alien Property Custodian vested this Volpertas application (PX 2, I-83) and in due course, the appeal to the Board of Appeals was dismissed without any decision on the merits by the Board of Appeals (PX 2, I-88). The dismissal of appeal operated as a final adjudication of unpatentability against Volpertas and gave rise to the application of the doctrine of *res judicata* as to the V-1 application, even though plaintiff contends otherwise.

In a situation, such as here, This Court recognized and applied the doctrine of *res judicata* when a patent applicant did not exhaust his right of administrative appeal. *Aetna Steel v. Southwest Products*, (CCA 9, 1960) 282 F.2d 323, at 334; cert. den. 365 U.S. 845.

(b) By the "V-2" application

On February 17, 1938, Volpertas applied for a French patent (DX 17, I 194-198)<sup>26</sup> and thereafter filed in the United States Patent Office application No. 254,739. These two disclosures were essentially identical. The file history proceedings in the U. S. application are shown in PX 2, I 100-104. The proposal of this application was to prepare a dry powder from vegetables, containing starch, *by mixing the cooked vegetables with a suitable quantity of dry powder, and treating this mixture in a heated drum provided with a stirring device.* The application states that an essential feature of the invention consists in the fact that the mixture of cooked vegetables and dry powder is treated "*in vacuo.*" (PX 2, I-101).

The application contained an example in which 32 kilograms of cooked potatoes were mixed with 8 kilograms of dry powder to obtain 16 kilograms of dry powder. The application then stated:

"In the example which has just been described it was assumed that the quantity of dry powder added to the cooked potatoes was 25% by weight. It is, of course, understood that *this proportion is only given by way of example* and that *it may vary from one case to the other, according to the nature of the vegetables treated.*" (Emphasis added) (PX 2, I-102)

In this V-2 application there were three original claims (PX 2, I-103). Claim 1 was directed to the add-back process and contained no limitation as to either the temperatures or pressure under which the process was performed. In original claim 2 the process was required to be performed in a "total vacuum" while in claim 3 the process was performed in a "partial vacuum."

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<sup>26</sup> This French Patent was patented (delivre) in March 1939 and was published in June 1939 early enough to anticipate Rivoche.

In due course the original claims were rejected and rewritten (PX 2, I 105, 106, 131, 132). New claims 4, 5 and 6 were each directed to a process of performing the add-back steps in the making of a dry powder without any reference to whether the process was being conducted under atmospheric or vacuum conditions. New claims 7 and 8 (PX 2, I-132) were product claims in which Volpertas attempted to claim the product of his process as a new product.

Also in due course, claim 4 was voluntarily canceled and claims 5 to 8 were finally rejected (PX 2, I-117) and an appeal was taken to the Board of Appeals of the Patent Office (PX 2, I-118). The position of the Patent Office with respect to this Volpertas application, and to the claims on appeal, was stated (PX 2, I 120-122). Thereafter, title in this application was also vested by the Alien Property Custodian (PX 2, I-142).<sup>27</sup> Here, too, the appeal was dismissed (PX 2, I-150) and the Patent Office refusal of claims 5 to 8 covering the process and product of the add-back process became final and *res judicata* against Volpert. (*Aetna Steel v. Southwest Products, supra.*)

(c) *In the "V-3", or patented, application*

On January 1, 1942, Volpertas, having apparently come to the United States, filed an application (PX 2, I 161-179) which was a composite of additions to, and deletions from, each of the prior Volpertas applications. This new application was filed with eight claims (PX 2, I 174-177). All of these claims were directed to a process. Volpertas had obviously abandoned any attempt to obtain a patent on a product. The new application contained no drawings such as in the earlier V-1 application. *Every original claim in this new Volpertas application required that, in part, the process be performed either by applying "vacuum,"*

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<sup>27</sup> The actual vesting orders for the V-1 and V-2 applications (as well as the Faitelowitz patent in suit) appear in DX 16, I 31-34.

"under vacuum" or "in vacuo." This was completely consistent with the statement in the earlier V-2 application (PX 2, I-101), that treatment *in vacuo* was an essential feature of the invention.

In due course, two of the original claims were held to be allowable while all of the remaining claims were rejected (PX 2, I-180). Thereafter most of the claims of the application, and expressly *including claim 3* thereof, which is now claim 3 of the patent in suit, *was amended to specify that the cooling was carried out to a temperature in the order of 10<sup>0</sup>C.* (PX 2, I-43, at line 2, and 182). In contending for the patentability of the claims which then stood rejected, the attorney (PX 2, I-184) called attention to the temperature limitation of 10<sup>0</sup>C. which had been added to the claims. He also emphasized the "*critical character*" of the claimed steps and made the following statement:

*"To accomplish the result, applicant guards against mechanical pressure in the early stages of the drying until the moisture content has been reduced to about half the initial weight. At that stage he cools the mass to a temperature in the order of 10<sup>0</sup>C. and under that condition he is able to reduce the mass to a moist powder by the application of mechanical pressure."*

The limitation of performing the process "in the absence of mechanical pressure" was conceded in the file to be a "critical limitation." The foregoing emphasizes that the limitations of claims 3 and 7 in suit were deliberately adopted by Volpertas to describe the differences thereof over the "crushing," or mashing, procedure of his V-1 case and the "add-back" procedure of his V-2 case.

The Trial Court's findings that Volpertas' acts giving rise to file wrapper estoppel, against Volpertas and plaintiff, as to claims 3 and 7 in suit (FF XX-XXIII 99, R 107-110) are correctly applied as to law and fully supported by the V-1, V-2 and V-3 cases, themselves.

## 2. Because of prior art.

The prior art requires a narrow construction of claims 3 and 7 of Volpertas. His broad add-back claims 1, 4, and 5-8 were refused in the V-2 application 254,739 principally on *Brüne* patent 1,304,845 (PX 2, I-212). This 1916 patent revealed a process of drying vegetables, including potatoes, by mixing previously dried vegetables with the vegetables to be dried and eliminating moisture from the mixture by pressure.

Defendant has presented prior art (more pertinent than *Brüne*) which was not cited by the Patent Office against Volpertas (or against Rivoche). This Court has held:

"Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated." (Emphasis added.) *Jacuzzi Bros., Inc. v. Berkeley Pump Co., et al.*, (CCA 9, 1951) 191 F.2d 632 at 634; see also *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.*, (CCA 9, 1961) 287 F.2d, 228 at 229.

If that be good law — and defendant submits that it is — it follows equally that "when the most pertinent art has not been brought to the attention of the Patent Office" the patent must be strictly construed if not also invalidated.

The 1907 French patent to *Steffen* [DX 17 (translation) I 163-170] discloses mixing raw potatoes in any shape, including *mashed*, with dried potato particles of the same size, letting the mixture reach moisture equilibrium and then drying the mixture by hot air or steam. Proportions of 100 parts of dry to 300 or 400 parts of wet potatoes are stated. While the translation describes the product as "fodder," at PX 2, I-169, the patent states that the product has the properties of



cooked potatoes and may be used for human consumption, with or without mashing. This is a clear disclosure of *add-back applied to potatoes*.

The 1929 French patent to *Jahn* [DX 17 (translation), I 174-177] recognized that "starch is a body very sensitive to heat which can only be dried at a *moderate heat*, of up to about 52°C. (125°F)." It recognized difficulties in vacuum drying, but in doing so it taught the antiquity of vacuum drying. *Jahn* recognized that dry starch is less sensitive to heat as it becomes drier. The patent then discloses the add-back process of admixing dried starch with moist starch and the mixture thereafter dried by steam heated surfaces. As much as 1/2 to 9/10 of *the dried product* is brought back for admixture with the moist material. The more sensitive the material (or difficult to dry) the larger the proportion of dry which is added back. The water content of the mixed material going to final drying may be "lowered to 22 to 24%." The patent teaches that the add-back process may be applied to "other similar substances" in addition to starch. The *Jahn* patent claims add-back broadly.

The 1930 German patent to *Sprockhoff* [DX 17 (translation), I-211, 212] discloses an improvement in the drying of starch by mixing 2000 parts of dry starch (20% moisture) with 1300 parts of wet starch to produce a mixture having 27.3% moisture and drying this mixture at low temperatures 45°C. to 50°C. (113°F. to 122°F.). The *Sprockhoff* patent claims add-back broadly followed by final drying at a "moderate temperature."

The doctrine of equivalents is elastic - but it must stretch in both directions. If claims 3 and 7 are to be stretched to cover defendant's predrying by add-back with mashing rolls or pug rolls then these claims are invalidated by *Steffen, Jahn* and *Sprockhoff*. That which infringes if later invalidates if earlier; this is particularly so when the great

extent of knowledge revealed by the art antecedent to Faitelowitz, *supra*, is considered.

**D. Other Limitations of Volpertas' Claims 3 and 7  
Are Admittedly Not Infringed.**

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Although the Trial Court's findings do not mention them specifically (FF XXIV, R 99, 110), there are at least two differences, shown by the evidence to exist, between defendant's processes and the claimed process asserted against defendant. *Neither pre-drying potato pieces in the absence of mechanical pressure thereon nor final drying "in vacuo" has ever been used by defendant.*<sup>28</sup>

During the inter-partes demonstration by defendant, at Caldwell, defendant demonstrated the mashing of cooked potato slices by mashing rolls and a double shaft mixer ("pug mill") [DX 47A, III-171 and (pictures) DX 47B, III-175, 182, 183, 188, 189, 190].

On the last day of trial Templeton reluctantly admitted (T 1605, 1606) that some mechanical pressure must be present to change potato pieces into a "mass" (mash). Templeton's admission was in accord with plaintiff's U. S. Department of Agriculture expert who testified that mashing cooked potatoes necessarily involves mechanical pressure and mashing by rolls cannot be performed "in the absence of mechanical pressure" (T 320).

During the defendant's inter partes demonstration at Caldwell, defendant demonstrated the several forms of atmospheric driers which defendant had used in final drying. The purpose of this was to show that defendant had never used a vacuum drier or dried "*in vacuo*" as required by Volpertas [DX 47A, III 161-165; DX 47B, III 181, 184-187].

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<sup>28</sup> Templeton admitted, at T 527, "I don't know what vacuum means."

Again on the last day of Trial Templeton finally admitted at T 1607, 1608:

"Q. As you were testifying about this Volpertas Patent, you related it generally to Defendant's operation as illustrated in the chart, Plaintiff's Exhibit No. 6, did you not?

A. Yes.

Q. Will you point out on this chart any place where there is employed a vacuum drying cylinder?

A. There is no vacuum drying cylinder of the type *Volpert here and elsewhere in this specification apparently had in mind in the Defendant's Plant.*" (Emphasis added.)

Templeton's admission was in accord with the testimony of plaintiff's other experts Olson and Harrington who testified that defendant's several successive types of atmospheric driers were not vacuum driers, or were not used as vacuum driers (T 274, 275, 303, 306-308).<sup>29</sup>

It is clear that defendant did not infringe Volpertas' claims 3 and 7 within the clear normal meanings of the terms used therein. If Volpertas had special definitions for such terms he failed to reveal them clearly in the manner required by Statute (§ 112, 35 U.S.C., or former R.S. 4888) and the Trial Court, correctly, so found.

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<sup>29</sup> Other evidence in this regard appears at PX 5, II 133, 134, 142, 172; T 104, 107-110, 114, 116, 120, 253, 258, 1134-1136, 1142-1146, 1158, 1180-1184.

**E. The District Court Committed No Error In Finding That Volpertas Was Not Infringed**

The Trial Court's findings (FF XIX to XXV, 99 R 107-110) that defendant had not infringed either of Volpertas' claims 3 and 7 in suit, and that Volpertas' acts, shown in the file histories of the "V-1," "V-2" and "V-3" patented application, established file wrapper estoppel were fully supported by the evidence and were based on sound decisions of This Court and of The Supreme Court. There is ample further evidence on non-infringement in addition to that particularized by the District Court. There is no "clear error" as to this patent.

**VII. ARGUMENT AS TO RIVOICHE**

**A. Claims 16 and 17 Cannot Be Valid on Any Basis**

**1. The claims are "interlopers"**

Claims 16 and 17 were injected into the Rivoiche application in 1950 as the result of a coldly calculated, but fortunately transparent, scheme to monopolize for plaintiff what Volpertas had surrendered in his V-2 application, and patent. To further this scheme plaintiff ignored the vested rights of the public, violated all principles of equity and violated nearly all of the patent statutes.

Plaintiff's Main Brief criticizes Mr. Simplot for never writing letters. Defendant sincerely thanks Mr. Templeton for being addicted to writing. Templeton's letters, while not always consistent, are very revealing. They make it easier to determine what Templeton had in mind ten or twenty years ago, than does his parol testimony at the trial.

Almost immediately after leaving Idaho in March 1949, Templeton wrote, from San Francisco, a letter of March 8, 1949 (PX 8, III-42). With this letter Templeton sent an unsigned *proposed agreement* (PX 8, III 43-46), and "*Explanation of U.S.A. Patent Position*" (PX 8, III 47-49), certain *proposals for laboratory work* (PX 8, III 52-53) *proposals*

for *Commercial Operation* (PX 8, III 55-56) and a dissertation on *Sales Policy* (PX 8, III 57-58). To avoid extensive quotations defendant has reproduced the foregoing in the appendix to this brief.

Templeton in this March 8, 1949 document ascribed to *Faitelowitz* (1) reduction of water content by "50% of the original weight" (by pre-drying) and (2) "preliminary drying by heat" [PX 8 at p. 47].<sup>30</sup> Templeton ascribed to Volpertas the add-back step (which is what Volpertas originally taught but does not claim).

Lastly, Templeton defined the *Rivoche* contribution as overcoming the disadvantage of the add-back step by freezing the cooked potato and removing water therefrom by "centrifuge or pressure." Templeton then said:

"By these means, *Rivoche* was able to reduce the water content *without heat*<sup>31</sup> and *without admixture*<sup>32</sup> and obtain the damp powder *without the foregoing disadvantages* and he *proposed the use of dry admixture only as a supplementary step*, as it were, for those occasions when the mechanical methods did not quite eliminate enough water for the final drying." (Emphasis added.) (PX 8, III-48)

With Templeton's foregoing description of *Rivoche*, defendant is in complete agreement. In the shorthand of this art *Rivoche* was proposing the "freeze-squeeze" process with only a little "supplementary add-back" when the freeze-squeeze was not sufficient of itself. That is the most that *Rivoche* described in his 1939 British<sup>33</sup> and his 1948 U. S. patent applications. That is what the file wrapper of the *Rivoche* U. S.

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<sup>30</sup> This is precisely what the Trial Court found.

<sup>31</sup> Thus avoiding *Faitelowitz*' process.

<sup>32</sup> Thus avoiding Volpertas' V-2 process.

<sup>33</sup> Defendant does not admit that the 1939 British applications disclosed this much.

patent application shows he was describing *and claiming* from February 1948 until 1950 (PX 3, II 12-72).

On December 7, 1949, Templeton wrote a letter to Kueneman, defendant's Research Director, saying that "the Volpertas proposal must give way to Rivoche on quality" and he, Templeton, must convert three of his plants from "Volpertas" to "Rivoche" (PX 8, II-143). This sounds innocent enough for, in the light of Templeton's March 1949 dissertation, Templeton seemed to be saying that the "freeze squeeze" method was better than the "add-back" method.

What Templeton was really saying was that a decision had been made to shift emphasis (in the Rivoche patent application) from the old Volpertas add-back to a new Rivoche add-back concept. New patent counsel appeared in the case (PX 3, II-72) and an amendment which made at least three significant changes in the Rivoche disclosure was presented in January 1950 (PX 3, II 73-80).

Thereafter, without any further action by the Patent Office, Rivoche presented a supplemental amendment on June 28, 1950 (PX 3, II 82-88). This supplemental amendment made further significant changes in the description, canceled all of the then existing claims 21 to 58 and replaced the canceled claims with new claims 59 to 77. Rivoche pointed out that claims "74 and 75" (which became claims 16 and 17 in suit) were "patterned after claims 1 and 2 of the Rendle patent" - namely, *U. S. Patent 2,381,838 of August 7, 1945* (DX 17, I 134-136).<sup>34</sup>

The Patent Office, in an astonishing display of in-expertise, accepted the ex parte representations of priority claimed for Rivoche and granted the patent in suit without the inter partes priority determinations required by statute. (35 USC § 135) The patent, as granted,

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<sup>34</sup> The ramifications of the changes and distortions of the Rivoche patented application have been presented in comparative tabular form in pages 44a and 45a of the Appendix.

contains some 19 claims all but two of which (the claims in suit) cover a process of cooling or freezing cooked vegetables, namely the "freeze-squeeze" process.

The two claims in suit are, as a court aptly said in similar circumstances, *interloper* claims. *Cleveland Gas Burner v. Am. Heater and Appliance Co.*, (CCA 8) 38 F.2d 760 at 763, 764.

"It is like the cowbird's egg deposited in the nest of another bird. It simply 'does not belong.'"

**2. The "interloper" claims violate statutes and controlling principles of law**

The pre-1950 "invention," if any, of Rivoche was, as aptly described in 1949 by Templeton, "freeze-squeeze." Templeton forgot himself during the Trial and admitted that freeze-squeeze was the *principal* contribution of Rivoche (T 231-232). Claims 16 and 17 of Rivoche<sup>35</sup> are far broader than that concept - "freeze-squeeze" is omitted and "add-back" is *the* primary step, not *a* supplemental one.

This violates *Kemart Corp. v. Printing Arts Research Labs, Inc.*, *supra*, at 629, 633:

"a patentee's broadest claim can be no broader than his actual invention . . ."

The "interloper" claims of Rivoche were inserted by a 1950 distortion of the disclosure of his then pending application and the insertion of a new concept - *new matter* - therein. New Matter is expressly prohibited by statute, 35 U.S.C. § 132, last sentence.<sup>36</sup> It presents in this case the same "*trilemma*" which This Court recognized in *Aetna Steel Products Corp. v. Southwest Products Co.*, *supra*, at page 334.

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<sup>35</sup> These claims are reproduced at page 40a of the Appendix hereto.

<sup>36</sup> Reproduced, Appendix page 21a.

The Rivoche claims in suit are, on mere inspection of the words thereof (Appendix page 40a), vague, indefinite and ambiguous. They violate the statutory requirement of claiming distinctly and with particularity (35 USC § 112) which is reproduced in Appendix page 20a hereof.

Consistent with *Halliburton Oil v. Walker, supra*, at page 13, a patentee cannot obtain greater coverage by failing to describe (or distinctly claim) an invention than by describing it as the statute demands.

The "interloper" claims of Rivoche were added to his application eleven years after he first sought a British patent. Between September 1939 and June 1950, World War II was fought and ended and a substantial war-time dehydrated potato industry was developed in Great Britain and this country by others than plaintiff. In addition to the Faite-lowitz and Volpertas patents<sup>37</sup> a very impressive body of information was published and entered the public domain. Examples of this are found generally in PX 11 (particularly the designated portions thereof) and in DX 34, III 8 to 127.

The effect of plaintiff's 1950 distortion of the Rivoche freeze-squeeze concept was to withdraw from the public domain much that had been freely acquired.<sup>38</sup> The Supreme Court said in the leading case of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, at 152; 71 S.Ct. 127, at 130:

*"The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary their effect is to subtract from former resources freely available to skilled artisans."*

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<sup>37</sup> The United States patents *and* their foreign counterparts.

<sup>38</sup> Defendant is confident that This Court knows that information disclosed in a foreign patent which has no United States equivalent patent is as freely open to use in this country as information in any (non-patent) printed publication.



The Rivoche patent violates every one of these controlling doctrines, and more.

**B. Even When Giving Rivoche a 1939 "Priority" Date  
Claims 16 and 17 Are Invalid**

Rivoche applied for his patent in suit in reliance upon "The Boykin Act."<sup>39</sup> For the purposes of this appeal only two provisions of this post-World War II enabling Act are important. *First* the Act restated the then controlling Statute (R.S. 4887) which like present Section 112 required *identity of invention* with respect to the applicant's corresponding foreign and U. S. applications. *Second* the Act required the applicant to supply certified copies of his foreign applications relied upon. (Boykin Act, Section 1 at "(1)" - Appendix page 23a).

Rivoche asserted reliance upon his British application filed September 16, 1939 (PX 3, II 50-64), and his British application filed December 15, 1939 (PX 3, II 35-43). He supplied certified copies of these British applications as filed in 1939 and of one of them as re-filed, in amended form, on July 18, 1946 (PX 3, II 44-49).

The Patent Examiner blindly accepted the representations for Rivoche that his 1939 British applications disclosed the subject matter of interloper claims 16 and 17. Defendant denies this and has consistently done so since 1949. The Trial Court made no express findings relative to Rivoche's priority applications; obviously he was so convinced of the invalidity of the two claims in suit as to find it unnecessary to reach that defense.

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<sup>39</sup> The entire Statute has been reproduced in the Appendix hereto at pages 23a to 28a.

For the purpose of sustaining the District Court's judgment as to Rivoche it is unnecessary for This Honorable Court to consider the sufficiency of Rivoche's priority claim. The claims are invalid for want of invention for the reasons stated by the Trial Court.

1. By reason of prior art which antedates September 16, 1939

The same prior patents which antedated Volpertas and Faitelowitz are anticipatory, for what they taught, with respect to Rivoche. Thus Rivoche was confronted with the existing skill of the art which showed that the add-back step was old in pre-drying starchy materials, including potatoes, and that variations in proportions of the moist and dry materials, to produce mixtures containing considerably less than 50% moisture, were known. This knowledge is explicit in the 1907-1930 patents to *Steffen, Jahn* and *Sprockhoff* which have been discussed in this brief *supra*.

In addition, the 1937 U. S. patent to *Credo* (DX 17, I 108-113) shows, in Figure 1 (I-108) of the patent, apparatus for the drying of starch cake by mixing wet starch with dry starch, thereafter drying the mixture and returning dried starch, clearly use of the add-back principle. The moisture content of the mixture of wet and dried starch is less than 50% as explained in this patent.

The August 8, 1939, patent to *Horesi* (DX 17, I 125-128) discloses, in the drawing (I-125) the mixing of wet and dry starch, the drying of the mixture, passing the mixture through a screen 17 and returning dried particles as an add-back for admixture with moist starch.

Plaintiff cannot effectively "brush-off" these prior art vegetable drying and starch-drying patents on the ground that they are not relevant to potato powder. The test of relevancy is the scope of the claims in suit. This Court will observe that claims 16 and 17 of Rivoche are not limited to potatoes - on the contrary they are broadly directed to

"cooked *starchy vegetable foodstuff*" with no further details of nature or particle size than "mass of the cooked vegetable."

The prior patents of *Faitelowitz* and *Volpertas* are also highly relevant. They relate directly to cooked potatoes, as well as other "starchy vegetables."

For the purpose of this argument any of the British, French or United States patents of *Faitelowitz* may be used. They have essentially similar disclosures and all three were both patented and printed prior to 1939 (PX 1, I 2, 3 and DX 17, I 150-151 and I 178-186). *Faitelowitz* shows, and plaintiff has conceded as much, a predrying to a moisture content which is both above and below 50%.

For the purpose of this argument certain of *Volpertas*' foreign patents are anticipatory in that they were both patented and published prior to September 16, 1939.<sup>40</sup> *Volpertas* obtained British and French patents on his "V-1" proposal (DX 17, I 152-154 and I 199-209). The V-1 patents of *Volpertas* show, what his abandoned U. S. application Serial No. 234,261 also showed, predrying to a moisture content which is both above and below 50%.

Defendant's expert, Dr. Jackson, established that when the various instructions of *Faitelowitz* and *Volpertas* (in his V-1 foreign patents) are applied as to the moisture content of partially dried potatoes, the pre-dried "damp powder" has a moisture content within a range which is both above and below 50% (T 1194-1203; DX 38, III 145-153).

For the purpose of this argument the *Volpertas* V-2 French patent is anticipatory to *Rivoche* since it was patented and published prior to September 16, 1939. This French patent (DX 17, I 194-198) shows the

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<sup>40</sup> The relationship, time-wise, of the various *Faitelowitz* and *Volpertas* patents to the *Rivoche* patent, is shown graphically in DX 21, II 24-25.

same example and the same instructions to vary the proportions between dry potato powder to cooked wet potatoes which were given in Volpertas U.S. application Serial No. 254,739 (discussed in this brief at page 38-39, *supra*).

The Volpertas V-1 and V-2 U. S. applications are themselves anticipatory to Rivoche within the doctrine of *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390, which has been codified in 35 U.S.C. § 102e (as the "Reviser's Note" to Section 102 shows in U.S. Code Annotated).

When the anticipatory prior art is matched against claims 16 and 17 of Rivoche (as it must be) the *lack of invention* demonstrated in these two claims is very clear. Within the standard of measurement which This Court expressed in *Wilson-Western Sporting Goods v. Barhart* (CCA 9, 1936) 81 F.2d 108, at 110 and 111, and cases cited therein, the Rivoche add-back method was obvious. This Court's views on obviousness are in accord with the views expressed by The Supreme Court in *Sinclair & Carroll Co. v. Interchemical Corporation*, 325 U.S. 327, 65 S.Ct. 1143 (1945), which was cited and quoted by the District Court in his Memorandum Opinion. It is also in full accord with *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560, at 566, 69 S.Ct. 269 at 272 (1949).

## 2. By reason of Templeton's admissions.

In *Jungersen v. Ostby*, *supra*, The Supreme Court commented on an admission of "identity of principle" by the patentee. Here we have admissions of equal force. Templeton volunteered as to Rivoche (T 232):

"I have always given him the very clear instruction as to the moisture range.<sup>41</sup> Whereas his co-partners had been content with this reduction of 50 to at the most 60 per cent in the main; when you apply that to potatoes ranging from 75 to 85, *mathematically the range is pretty wide and Rivoche knocked off the top of the range. He said: 'No, not above 50 - 50 or below.'*"

That is not all. Testifying as to the moisture ranges disclosed by both Faitelowitz and Volpertas, Templeton said (T 1652-1653):

*"I have agreed that Volpertas and Faitelowitz propose a damp powder which a certain moisture content of potatoes goes below 50 per cent."*

### 3. Because there is no presumption of validity as to Rivoche

Defendant directs the attention of This Court to the circumstance *that not one of the prior art patents referred to, supra, was considered by the Patent Office or called to the attention thereof by Rivoche during the file wrapper proceedings of this patent.* [The Volpertas patent in suit was cited but apparently was withdrawn on the representations for Rivoche that Volpertas was different because it showed "vacuum" for cooling and did not show temperatures as low as 4<sup>0</sup>C. (PX 3, II-67).] The presumption of validity created by 35 U.S.C. § 282 is "overthrown" and "dissipated" in this patent.

"But further, a great many of the patents, which were brought to light in this lawsuit and considered by the Trial Court, had not been previously considered by the Patent Office. Even one prior art reference, which has not been considered by the Patent Office, may over-

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<sup>41</sup> This is an over-statement. The upper limit is "about 50%" and there is no lower limit in claims 16 and 17 or in the entire patent.

throw the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here.

"The presumption of validity of administrative grant has been in recent years almost reduced to nullity in patent cases. The justice of the abandonment of this doctrine might be claimed because some absurd results have been reached by administrative bodies. However, no matter what defects there may be in administrative bodies or courts composed of experts, questions of fact should be settled in the trial tribunal, reversible only because of clear error." *Jacuzzi Bros. v. Berkeley Pump Co.* (CCA 9) 191 F.2d 632, at 634.

"Generally, the action of the Patent Office in allowing the patent creates a presumption of validity. However, even one prior art reference which has not been considered by the Patent Office may overthrow this presumption. *Mettler v. Peabody Engineering Corp.* (9 Cir., 1935) 77 F.2d 56, 58; *McClintock v. Gleason* (9 Cir., 1938) 94 F.2d 115, 116; *Jacuzzi Bros. v. Berkeley Pump Co.* (9 Cir., 1951) 191 F.2d 632, 634. When the most pertinent art has not been brought to the attention of the administrative body the presumption is largely dissipated. *France Mfg. Co. v. Jefferson Electric Co.* (6 Cir., 1939) 106 F.2d 605; *Jacuzzi Bros. v. Berkeley Pump Co.*, supra. The facts in the present case justify the invocation of such rules." *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.* (CCA 9) 287 F.2d 228, at 229.

### C. The Rivoche Claims 16 and 17 Are Anticipated By Post-1939 Patents

The Trial Court did not expressly reach the question of the sufficiency of the Rivoche claim to a 1939 priority date. This Court need not reach the question unless it finds, contrary to the Trial Court, that there is "unobvious" "invention" in Rivoche. The assumption that the

September and December, 1939, British applications of Rivoche (PX 3, II 50-64 and II 35-43, in that order), collectively or individually disclose the subject matter of claims 16 and 17 of the Rivoche patent is contrary to fact. To avoid detailed discussion of these two British applications their disclosures have been tabulated and compared at Appendix pages 41a to 43a, *infra*.

Without engaging in detailed discussion of the September 1939 application its disclosure may be summarized as a proposal to dry an enormous category of foodstuffs, including green leafy vegetables and meats, by cooking the foodstuffs "without added water," then "cooling" and "mechanically removing the water" from the cooked, cooled foodstuff. A moisture removal range of from 45% to 75 to 80% is mentioned. For starchy materials a "preferable" figure of "no more than 50%," but for all "materials" "usually not more than 50% by weight of water," is given.

No example giving the drying of any foodstuff is given; no drying temperature is given, in short the disclosure is an encyclopedia of questions with no answers. We defy plaintiff to read the case and tell how to apply any add-back step to green vegetables or meats. Templeton could not tell (T 485, 486). Templeton's testimony on this British Rivoche "disclosure" went far in destroying his qualifications as an expert in the drying of all foods including meats. He thought "pemmican" was the name of an American animal (T 445, 446, 601, 605, 606), and he had never heard of "biltong" (T 973, DX 26, II-46). Yet pemmican, biltong, the dried potatoes of the Incas (T 673), ordinary smoked ham, dried peas, beans and corn are all squarely within the reach of this fantastic "proposal" of Rivoche.

The September 1939 Rivoche application is a perfect subject for the critical application of the sound legal principles applied in similar cases. *National Theatre Supply Co. v. Da-Lite Screen Co.* (CCA 7,

1936) 86 F.2d 454 at 455; *Kruger v. Whitehead, supra*; and *Craftint Mfg. Co. v. Baker, supra*.

The December 1939 British application is not much better. The sole contribution of this otherwise vague and indefinite disclosure is to tell what Rivoche meant by "cooling" his welter of materials. Cooling was 4° C.<sup>42</sup> or below, to include freezing.

Neither of the two British applications of Rivoche, singly or in combination, complies with the requirements of Section 112, 35 U.S.C. for disclosure in "full, clear, concise, and exact terms" or "setting forth the best mode contemplated by the inventor for carrying out his invention." Neither of the two British applications would (even if in proper form) support a U. S. patent for claims 16 and 17 of the Rivoche patent in suit. Both applications merely invite the art to experiment in a vast field of dried products. They are, as stated in *Craftint v. Baker*, "a mere suggestion of a process not disclosed."

Defendant asserts that *Rivoche has no 1939 priority* and, lacking such, *must rely on the 1948 filing date* of his U. S. patented application for whatever it is worth.

The 1944 patent in suit to Volpertas is an exact anticipation of claim 16 of Rivoche. The Volpertas patent does not disclose the "sieving operation to disintegrate" called for by claim 17 of Rivoche - but then both of the British Rivoche applications are equally lacking in disclosure of such a sieve. However, the 1945 patent to Rendle (DX 17, I 134-136), does expressly disclose and claim such an operation. Indeed Rendle's claim 1 (I-136), is the very claim Rivoche pilfered in 1950.

Volpertas and Rendle anticipate and invalidate Rivoche claims 16 and 17 under the provisions of Sections 102a and 102b of 35 U.S.C.

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<sup>42</sup> 4° C. is 40° F.



Volpertas invalidates Rivoche for another reason. Section 102f of 35 U.S.C. invalidates an "invention" which the patentee did not invent. A valid patent can only be granted to "the original inventor." Plaintiff has freely conceded that Volpertas, not Rivoche, is the father of add-back.<sup>43</sup> The Trial Court's finding that Rivoche did not himself invent the subject matter of claims 16 and 17 is free of error (FF XXVII, 99 R 111, 112 - Appendix pages 13a, 14a).

#### **D. The District Court Committed No Error in Finding That Rivoche Was Invalid**

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The District Court's findings that Rivoche was not an original inventor and that claims 16 and 17 were invalid for want of invention were free of error. *There can be no invention in remonopolizing the lower part of the moisture range which Faitelowitz and Volpertas each taught at an earlier date.*

The District Court could have found, also without error, that claims 16 and 17 of Rivoche were invalid by reason of "new matter" (Section 132), by reason of "indefiniteness" (Section 112), by reason of exact "anticipation" (Sections 102a and 102b).

### **VIII. TEMPLETON'S COURT ROOM DEMONSTRATION WAS A TACTICAL MISTAKE**

Using a piece of laboratory apparatus so small he called it a "toy," Templeton demonstrated the *Faitelowitz method* and the *Volpertas method*.

Templeton succeeded in showing that the *Faitelowitz method* will work in the laboratory (defendant has never denied this). But in making the method work, Templeton demonstrated the complete lack of any

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<sup>43</sup> Defendant concedes that this is so when Volpertas and Rivoche are considered apart from all other prior art.

commercial utility in Faitelowitz. The predrying required most of an afternoon, the moist product was squeezed in a bottle and left overnight. Most of the next morning was consumed in drying, grinding and sifting the product. Even with this impractical consumption of time he got a mere thimbleful - 2 to 4 grams - out of a good sized Idaho potato.<sup>44</sup> If ever the old expression about a mountain laboring to bring forth a mouse applies anywhere it applied here.

In demonstrating the Volpertas method he made a product by the add-back step. Defendant has never denied that Volpertas disclosed the add-back step - defendant's contention has been that Volpertas *surrendered the step and failed to claim it in his patent*. Actually what Templeton was demonstrating was the subject matter of Volpertas' French Patent 842,651 (DX 17, I 196-198) - the "V-2" method.

While demonstrating the methods which Templeton ascribed to Faitelowitz and Volpertas he succeeded in completely destroying Rivoche. In his demonstrations of each of these methods which antedate Rivoche, Templeton carried the predrying steps of Faitelowitz and of Volpertas well below the 50% moisture figure which Rivoche later tried to preempt. Templeton succeeded in showing, as convincingly as defendant can argue, that claims 16 and 17 were highly obvious to a man of ordinary skill in the art. He made the invalidation of claims 16 and 17 by reason of Section 103 of 35 U.S.C. both proper and inevitable.

## IX. ANSWERS TO APPELLANT'S BRIEF

### A. Plaintiff Has Retreated and Narrowed the Real Issues.

Several general observations may be made concerning plaintiff's Brief relating to Appeal 18899. Plaintiff's brief is essentially argumentative with relatively few references to specific supporting evidence.

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<sup>44</sup> T 235-251, 309-311, 327-355, 1064-1070.

Plaintiff seems to have continued to retreat from the position alleged in its original complaint. There, every one of 39 claims in *four* patents was asserted against defendant. Here, only three of the eleven claims in suit are stressed in any particularity. Indeed, from plaintiff's statements at the foot of page 114 of its brief<sup>45</sup> it seems as though plaintiff is proposing "a deal" with This Court. Plaintiff suggests that if This Court will only hold Volpertas valid and infringed plaintiff will concede the obvious - namely that Rivoche is invalid. That narrows the issue to two claims, claim 1 of Faitelowitz and claim 7 of Volpertas. It also narrows the issue to questions of fact which were correctly determined by the District Court.

In another sense plaintiff has also retreated. The so-called contract case No. 18900 has from its inception been treated by plaintiff as a secondary afterthought. Before the District Court plaintiff gave first place and primary emphasis to the patent action - three-fourths of plaintiff's post-trial briefs were devoted to this case. Here the reverse is true; a mere one-third, and the last third, is devoted to Appeal 18899. This re-emphasizes the force of defendant's assertion to the District Court - plaintiff has no real expectation of sustaining the "F-V-R" patents in this infringement suit.

### **B. Plaintiff Now Relies on "Equities" and Not on Facts or Law**

An ancient axiom has it that when both the facts and the law are against an advocate he should argue the equities. Plaintiff has evidently heard and heeded this advice. Without support of prior pleading in either plaintiff's complaint or reply to counter-claim and with no affirmative advocacy thereof during trial, plaintiff now asserts in this

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<sup>45</sup> This statement continues on page 115 thereof.

case that defendant is licensed and therefore cannot contest the validity of the patents in suit.<sup>46</sup>

Entirely apart from the fact that the existence of any license is the fundamental question in Appeal 18900 and that the new assertion of license in this patent appeal comes at an inexcusably belated time, there is no merit in plaintiff's position.

Defendant would prefer to leave all arguments relating to a so-called license to its brief in Appeal No. 18900, where it belongs, but since the issue has been raised in this patent case, it must be refuted herein. Defendant's refutation will be limited as much as possible to the evidence of a technical nature which contradicts plaintiff.

Plaintiff cannot deny that no written license was ever entered into between the parties. The Trial Court's findings on this point are beyond dispute. Plaintiff therefore asserts an implied contract arising out of equitable considerations. But one who invokes equity must come into court with clean hands - plaintiff's are by no means clean.

Templeton testified that in 1945 he told Mr. Simplot to beware of the F-V-R patents and that he, Templeton, promised to give defendant first opportunity for license (T 175, 185, 186). Templeton would have to have possessed the prescience of an oracle to have known *in the fall of 1945*: (1) that Congress would enact the Boykin Act'' in August 1946, (2) that the Rivoche patent was going to be applied for in 1948, and (3) that plaintiff was going to persuade the Government of the United States to part with some interests in the Faitelowitz patent in 1956. What Templeton may have had was the "mental reservation" he acknowledged on October 12, 1949 (PX 8, III-133 at "1").

When Templeton first broached the matter of licenses in 1948, he limited discussion to the Volpertas patent and the (then) Rivoche appli-

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<sup>46</sup> Page 13 of Appellant's main brief.

cation. There was no mention of Faitelowitz or of an "exclusive" license. On the contrary Templeton was negotiating in Maine and had to return to this country the following January. This is explicit in his letter of November 18, 1948 (PX 8, III-34, 35).

### C. Plaintiff's Hands Were Not Clean

At the time Templeton negotiated with defendant and performed some laboratory demonstrations in Idaho in early March 1949, he was already negotiating with R. T. French Company (T 682-684, 732). After his March 1949 visit to Idaho and before returning to England that month, Templeton negotiated with the U. S. Government in Washington, D. C., for potato drying in Maine<sup>47</sup> (T 681, 736, 737). He must have negotiated with the Hume interests in California. This is implicit in his letter of March 31, 1949 (PX 8, III 72, 73).

Notwithstanding these activities with others, Templeton offered defendant an *exclusive* license on March 8, 1949 (paragraph "1(h)," PX 8, III-44). This *exclusive license was soon retracted* in the Dean Edmonds draft (paragraph "8," PX 8, III 64, 65, last six lines; T 743), *but was re-offered* in December 1949 in the form of the "annotated Heads of Agreement" (reproduced as Appellant's Appendix pages 18a-21a). Templeton's dealings with others before and after the Idaho trip do not show clean hands.

But in March 1949, plaintiff did not own what Templeton offered to license. All title to the Faitelowitz patent was in the United States Government. The Volpertas patent was not assigned to the Templeton interests until *April* 8, 1949, and the assignment was not recorded for public inspection until *December* 21, 1949 (DX 16, I 59, 60). Templeton did own the pending Rivoche application but its then scope was lim-

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<sup>47</sup> Whether this Maine operation was the same covered in his November 18, 1948 letter, *supra*, he succeeded in concealing throughout the Trial (T 410).

ited to the freeze-squeeze process. In March 1949, Templeton had nothing to back up his offer of an exclusive license.

**D. Plaintiff Supplied Nothing New and Useful in Templeton's  
1949 Idaho Demonstration, or Thereafter**

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Templeton's March 1949 Caldwell laboratory "demonstrations" used 12 *baked* potatoes, 11 of which were *baked and frozen*. As to *Faitelowitz* he dried "*shreds of riced or broken pieces*" until they lost 50% or at most 60% of their initial weight and recommended further laboratory experiments on this proposal. As to *Volpertas* he used the "add-back" step and recommended laboratory work to see how *little dry powder was needed*. As to *Rivoche* he *froze and centrifuged*, or *froze and squeezed*, the potatoes and recommended a larger *laboratory centrifuge* for future work (PX 8, III 52, 53).

In his March 8, 1949 "Proposals for Commercial Production" (PX 8, III 55, 56), *Templeton advised defendant* that its commercial process would "*have to follow the teaching of Faitelowitz*." He elaborated to describe predrying of *riced potatoes* until they weighed 50% of their original weight then *grinding* the predried potatoes by "*percussion*" or "*impact grinder*" and *final drying in steam heated mixers*. There is no hint in this proposal of add-back or of the *Rivoche freeze-squeeze*.

Later in the spring Templeton sent to defendant a drawing of a *laboratory device* (DX 19A and 19B, II 12-15), and drawings and photographs of a *steam-heated mixer* (PX 12 and PX 13, III 318-327). That is all he supplied.

Some of this "information" supplied by Templeton was misleading and all of it was useless from a practical viewpoint.<sup>48</sup> The direction to follow the *Faitelowitz* process would have put defendant in the unique

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<sup>48</sup> The suggestions which defendant did not follow or use in its commercial operations have been italicized for emphasis.

position of being the only potato processor in the world ever to practice that useless method.

Either Templeton was deliberately trying to mislead defendant or he did not know what he was talking about. The same may be said about his failure to recommend add-back to defendant.

In any event defendant never used anything that Templeton demonstrated, described, or supplied in 1949<sup>49</sup> *except the "add-back" step*. But that was *not new to defendant*. It had been repeatedly described in patents and publications which defendant possessed prior to March 1949 (DX 34, III 3 to 127, T 1048), and a commercial process which used the method had been seen and sketched in England in 1943 by Kueneman (DX 28A, 28B, II 63 to 65; T 980-984 and T 1032-1035).

What Templeton did supply was aptly characterized by a famous Englishman:

"Too little and too late."

The misleading and essentially useless "information" supplied by Templeton to defendant in 1949 is not adequate basis for a claim of unjust enrichment nor basis for a license "agreement" which is allegedly implied on "equitable" principles.

#### **E. Plaintiff Was Guilty of Laches**

Defendant pleaded this defense in this case, put in evidence to sustain it and briefed it after trial. The District Court made no finding in this case but expressly found plaintiff guilty of laches in the so-called contract case; on the same evidentiary basis. Since plaintiff invokes equity in support of its claim of "license" defendant reasserts its defense of laches.

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<sup>49</sup> Or thereafter.

At least as early as the potato season of 1950-1951, Templeton and his agent Scott had knowledge of defendant's manufacture of "Potato Granules" (DX 8, III 188, 189). At all times from and after August 1950 the Templeton interests had title to the Volpertas and Rivoche patents in suit. Suit herein was not filed until February 1959.

The only explanation which plaintiff ever offered for this *delay of eight years*, during which defendant was expanding its business, was plaintiff's desire to sue on all three patents. This it could not do because Faitelowitz was held by the Government. But as shown in this brief, *supra*, Templeton admitted that the three patents are mutually exclusive, certainly as to Faitelowitz (T 650-653, 783-789). There was no valid reason why plaintiff could not have sued on Volpertas and Rivoche, particularly while possessing knowledge that the Faitelowitz method was not being used anywhere in the world, including defendant's plants (T 564).

Plaintiff seeks to excuse its delay in not instituting divestment proceedings relative to the Faitelowitz patent by asserting inability to locate one Bunimovich. There are two answers to this excuse. Plaintiff's counsel recognized the need to institute divestment as early as June 10, 1949 (DX 8, III-110). Secondly, the 1936 British patent to Faitelowitz showed on its face that Bunimovich was a citizen of Venezuela (DX 17, I-150). Venezuela is not a very large country and it is precisely where Bunimovich was located. Plaintiff's delay between 1949 and 1956 with regard to divestment of Faitelowitz is itself inexcusable laches. Plaintiff's action on all three patents should be barred by laches. *Craftint Mfg. Co. v. Baker, supra*, at 374; *Pearson v. Central Illinois Light* (CCA 7) 210 F.2d 352 at 356.



**F. Defendant Did Not Produce "Potato Granules" Between  
1945 and 1950 Because There Was Not Sufficient  
Demand to Justify Production**

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Plaintiff has contended, and succeeded in convincing the Trial Court, that there was no evidence offered to explain why defendant did not manufacture dehydrated potato powder on a commercial basis before 1950.

The evidence is in the record. It shows that there was not a sufficient peace-time demand for the product to justify commercial production.

Templeton's dissertation on "Sales Policy" which was sent to defendant March 8, 1949, spoke of the "anticipated" total market and admitted that the quality of the product (produced in the United Kingdom - i.e. *his* product) had "not been good enough to hold steady and reliable trade amongst the highly discriminating domestic demand\* \* \* \*" (PX 8, III-57 and at III-58), said:

**"It is quite clear that success in the present development generally is more dependent upon the solution of marketing difficulties rather than production problems\* \* \* \*"**

Templeton's agent Scott wrote defendant on August 23, 1950,

"As you know, *the Army is in the market* for Instant Mix or Potato Granules Type IV and *with this business and* also considering *the potential consumer market*, believe the item has good *possibilities*."

Plaintiff's witness Olson testified that after the Korean War started, the Quartermaster Corps' interest in dehydrated mashed potatoes stimulated work by the Department of Agriculture (T 301).

Templeton testified that he had known for some years how to make dehydrated pea granules and dehydrated yam granules but never went into production because *he* could not see a commercial market (T 495, 499, 500). Peas and yams are within the ambit of the disclosures in

each of the three patents in suit and are embraced by 9 of the 11 claims in suit.<sup>50</sup>

When defendant obtained an Army contract in 1950 defendant went into production at once, with no help from plaintiff, because of the urgency of the Korean situation (T 395).

Defendant went into production using the same add-back process which Kueneman had seen during World War II (T 980 to 984, T 1032 to 1035). This was long before the Rivoche British or United States patents were published.

In 1945, Rendle United States patent 2,381,838 was published. The patent clearly discloses preparing dehydrated mashed potatoes by the add-back method in which the mixture of mashed potatoes and dry granules contained 40 to 50% moisture. Yet plaintiff's position is that publication, by Rivoche, of the same method five years later received immediate commercial acceptance. This is an absurdity on its face. *The patented publication by Volpertas in 1944 led to no acceptance, immediate or later. Neither did the 1938 patented publication by Faitelowitz - this was "never" used.*

Yet plaintiff argues that Faitelowitz was a "pioneer" patent. If Faitelowitz was a pioneer he certainly did not blaze any trail which others could follow. His moisture removal directions are self-contradictory. His temperature directions leave unanswered the question of whether the stated temperatures are those of the hot vegetable or the temperatures of the air, surface or other medium which supplies the heat to dry it. His "best mode" of carrying out his process was useless.

None of the three patents in suit has the merit of immediate public acceptance before or after 1950. Defendant's lack of commercial

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<sup>50</sup> Only claims 3 and 7 of Volpertas are limited to "potatoes."

production prior to the Korean emergency was attributable to one thing, and *only* one thing - there was no market for the product. Defendant has the same explanation which was supplied by Templeton, who wrote in 1949 that *sales presented far more difficulty than production.*

### G. Plaintiff Prays for the Impossible

Plaintiff's Main Brief asks This Court to hold valid and infringed one claim from each of the three patents in suit. To answer that prayer This Court would have to decide *de novo* the issues of validity of Fایتel-owitz and Volpertas, plural issues of validity of Rivoche which the Trial Court did not reach, and the issue of infringement of Rivoche, which is by no means conceded. That procedure is in violation of Rule 52a, FRCP. If This Court properly refuses to act *de novo* the alternative course would require remanding to the District Court for further findings and then further consideration on appeal.

On the contrary to affirm the decision below all This Court must do is to accept the completely correct findings of the Trial Court, adhere to the requirements of Rule 52a FRCP and applicable patent statutes, and follow a few decisions of The Supreme Court and of This Court. These decisions which are applicable and controlling, and most of which were adhered to by the District Court, are *Plastino v. Mills*; *Englehard Industries v. Research Instrumental*; *Moon v. Cabot Shops*; *Graver v. Linde*, 336 U.S. 271; *Kemart v. Printing Arts*; *Nelson v. Batson*; *Jacuzzi Bros. v. Berkeley Pump*; *Jaybee Mfg. v. Ajax*; *Craftint v. Baker*; *Aetna Steel v. Southeast*; *Halliburton Oil v. Walker*, 329 U.S. 1; *Jungerson v. Ostby*, 335 U.S. 560; and *Great Atlantic & Pacific Tea v. Supermarket*, 340 U.S. 147; each cited and applied *supra* in this brief.

In the final analysis all of the issues of this case are compressed within the language of an old decision.<sup>51</sup> *Knight Soda Fountain v. Walrus Mfg.*, (CCA 7, 258 F. 929 at 931). The Court there said:

"A patent is the creature of the statute \* \* \* \* *What is not claimed distinctly in the invention the public possesses. A patent is sustained not for what the inventor may have done in effect, but for what is pointed out clearly and distinctly in his open letter.*" (Emphasis added.)

#### **H. The Trial Court Lacked Jurisdiction Over Indispensable Parties**

Some "puffing" from a patent promoter like Templeton is to be expected, but persistent exaggeration, contrary to fact, is discrediting. In 1949 Templeton wrote that the F-V-R "patents" had been sustained and recognized in England; during the trial the same assertion was made (PX 8, III-133; T 181).

On cross-examination Templeton finally admitted that *the only patent sustained* in England was the V-2 British patent of Volpertas (T 679, 680).<sup>52</sup> The Rivoche British patents were not sustained; nor was the Faitelowitz British Patent (T 679). Indeed Templeton admitted that his interests had never acquired title to the British Faitelowitz patent (T 677, 679, 680, DX 15, I 11 to 17, 21).

Defendant has always contended, and here asserts, that plaintiff never acquired sufficient interest in the U. S. Faitelowitz patent in suit to maintain suit thereon without joining one or more parties who were never joined (99 R 25, 26). Lack of jurisdiction cannot be waived even

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<sup>51</sup> See also *Simons v. Davidson Brick Co.* (CCA 9, 1938) 106 F.2d 518, at 522, 523.

<sup>52</sup> British patent 525,043 (DX 17, I-156, 157) like the Volpertas V-2 U.S. abandoned application claims the add-back step broadly.

though, as here, it has relatively little materiality where plaintiff's action has been completely dismissed and defendant has been granted injunctive relief.

The Faitelowitz patent in suit was granted after assignment of 75% interest in the patent to one Bunimovitch (DX 16, I-26). Thereafter, Faitelowitz assigned to Volpertas and Rivoche, jointly "his half interest" in the patent (DX 16, I 28, 29). These assignments purported to transfer 125% of the patent. In due course the Alien Property Custodian vested all 125% of the title to Faitelowitz' patent (DX 16, I 32, 33).

The patent expired May 31, 1955. Sometime during 1955 proceedings were instituted by Templeton, on behalf of Bunimovitch, Volpertas and Rivoche, to have title to Faitelowitz divested. In 1956 the U. S. Department of Justice issued return orders to Bunimovitch and to Rivoche and Volpertas. The Bunimovitch return order appears at DX 16, I-42, and the Rivoche, et al., return order at DX 16, I-43. *The Department of Justice by administrative order* gave Bunimovitch a 75% interest in the patent and gave Rivoche and Volpertas a joint 25% interest in the patent.

Between the date of grant of Faitelowitz patent in 1938 and the date of the return order in 1956 every document which purported to transfer an interest in the patent, including the two "return orders" expressly conveyed title to the patent *and the right to sue for past infringement*. This last statement includes an admittedly inoperative assignment made by Volpertas and Rivoche to Farmer's Marketing & Supply Company, in April, 1949 (DX 16, I-40). This 1949 assignment did nothing except further to muddy the water.

In the summer of 1956 Bunimovitch assigned to Farmer's Marketing and Supply Company his 75% title to the patent but *did not assign any right to sue for past infringement or any equitable interests in the patent* (DX 16, I 50, 51). Similarly, and at about the same time, Volpertas and Rivoche assigned to Farmer's Marketing and Supply Company

whatever title they possessed in Faitelowitz' patent *without assigning any right to sue for past infringement or any equitable interest in the patent* or the invention (DX 16, I 46, 47).

No supplemental assignments from Bunimovitch or Volpertas or Rivoche which purported to convey the right to sue for past infringement, or any equitable interest, were ever recorded in the Patent Office. Notwithstanding this, in 1958, Farmer's Marketing and Supply Company undertook to assign to the plaintiff herein all rights to Faitelowitz' patent including the right to sue for past infringement, *but without assigning any equitable interests in the patent* (DX 16, I 53-55).

Defendant submits that the chain of title clearly revealed by the foregoing recorded assignments is so defective that plaintiff cannot maintain action for past infringement of the Faitelowitz patent without joining the estate of Bunimovitch as an indispensable party to this action. Apparently Bunimovitch is deceased. Plaintiff's right to sue is also defective for the same reason, unless Volpertas and Rivoche are joined, for neither of these individuals ever parted with the right to sue for past infringement of the patent.<sup>53</sup>

The burden rests upon plaintiff to establish its right to sue and not upon defendant to prove the contrary. Plaintiff has not assumed its burden and cannot assume it by arguing that as a proposition of law the assignment of an expired patent automatically conveys the right to sue for past infringement. In the present instance, plaintiff must rely upon a title determination made by an executive department of the government.

Under the system of checks and balances of our government, defendant knows of no authority, by statute or otherwise, which deprives the judicial department and grants to an executive department any right to reform contracts and remove clouds on title.

For this additional reason plaintiff has no right to maintain suit on the Faitelowitz patent.

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<sup>53</sup> Indeed Volpertas and Rivoche each seem to have such residual rights in both the Volpertas and Rivoche patents in suit as to preclude suit in their absence (DX 15A and 15B, I 3 to 21).

## X. CONCLUSION

In this Appeal No. 18899 This Honorable Court should enter an order and mandate which affirms in its entirety the Final Judgement, entered May 24, 1963 in Civil Action 3514, by The Honorable United States District Judge, and which dismisses this appeal with prejudice.

Respectfully submitted,

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**CERTIFICATE**

I certify that, in connection with the preparation of this brief, counsel for defendant-appellee have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit (effective May 25, 1962) and that in their opinion, the foregoing brief is in full compliance with those rules.

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## APPENDIX



## THE FORMAL FINDINGS OF FACT

The following formal Findings of Fact II to XXIX (99 R. 96-114) have been reproduced for the convenience of This Court. In reproducing FF II to XIII (which correspond to those selected portions of the Trial Court's Memorandum Opinion "adopted" by plaintiff defendant has italicized language which is omitted from the quoted Trial Court's opinion. For completeness defendant has added FF XIV to XXIX as to which plaintiff's Brief is silent.

### II.

[99 R 06] Plaintiff is a British corporation *engaged only in patent licensing* and is owned principally by Robert A. S. Templeton and his wife. Templeton is the Chairman of the Board and its managing director. Defendant is a corporation of the State of Nevada and has a principal place of business in the City of Boise, State of Idaho. This Court has jurisdiction under Sections 1332, 1338(a), 1400(b), 2201 and 2202, Title 28, U.S.C.A.

### III.

The facts and circumstances of the two lawsuits are closely related. Each suit involves a process for making a dehydrated potato powder which will, when combined with warm milk or water, readily reconstitute into a palatable dish of mashed potatoes comparable with that made by the common method using *cooked* fresh potato. Defendant is one of the leading manufacturers of this product in the United States.

### IV.

Plaintiff is the owner of three U. S. Patents, each of which discloses a process of making said product, and *plaintiff* contends that the defendant's process infringes certain claims of each patent: [99 R 97] namely, claims 1, 2, 4, 5, 6, 7 and 8 of United States Patent No. 2,119,155, issued to Arnold Faitelowitz and Marcos Bunimovitch on May 31, 1938, *which patent expired May 31, 1955*, claims 3 and 7 of United States Patent

No. 2,342,670, issued to Zelmanas Volpertas on July 4, 1944, *which patent expired July 4, 1961*, and claims 16 and 17 of United States Patent No. 2,520,891, issued to *Farmers' Marketing & Supply Company* (on an application by Eugene Joel Rivoche) on August 29, 1950, *which patent expired September 16, 1959*.

## V.

The evidence discloses that *there had been a long-felt need for an instant mashed potato powder*. Both World Wars and the Korean War created a demand for *such a* dehydrated product as well as others. The minimum bulk and keeping properties of *such a powder* make it suitable for storage and, yet when combined with warm milk or water, it instantly makes an acceptable food. The *white* potato is particularly adaptable for such a product. *White potatoes contain solids (primarily starch) within the range of 17 to 26 percent by weight and approximately 83 to 74 percent water by weight (Plaintiff's Exhibit No. 5)*. Many prior workers recognized this fact, but until the 1930's none had been able to discover a process which would produce an acceptable food. Prior thereto, inventors had been able to *perfect* processes for drying potato pieces or strips, or for making potato flour, which flour could be used indirectly in the preparation of foods. However, in attempting to develop an instant mashed potato *powder*, two problems *were always present in order to render it reconstitutable when combined with [99 R 98] warm milk and water*: first, *the processor* had to prevent the starch cells from rupturing, and *the potatoes from scorching* while being processed, or otherwise the reconstituted product would be pasty and unpalatable; second, *the processor* had to prevent the outer layer cells from hardening when drying. This hardening is sometimes referred to as "case-hardening."

## VI.

The first substantial contribution to the art of processing an instant mashed potato powder was made by Arnold Faitelowitz, in Paris, France, in the 1930's. He *taught* that the starch cells of most starch-containing vegetables could be separated without rupturing them if the *cooked* vegetable was first partially dried to a moist powder, which had lost at the

most about 60 percent by weight of its original water content (*or lost about 50 to 60% of the original weight of the raw vegetable*) before it was put through a second drying stage to reduce it to a *dried* product containing only 10 to 15 percent water content. Each of said drying stages was accomplished by means of heat. *The first such stage was applied to the cooked vegetable which had been cut into small pieces and the second such stage was applied after the predried small pieces had been grated or crushed.* Faitelowitz applied for a patent in Great Britain on June 10, 1936, which *British* application serves as the basis for his United States Patent.

## VII.

*The evidence shows and both parties admit that the Faitelowitz process is somewhat crude and difficult to perform. The cutting of the whole potato causes cell rupture.* Unless the [99 R 99] drying stages are conducted very skillfully, the heat causes case-hardening. As a result, *the Faitelowitz process* has never been used for commercial production anywhere in the world. However, it served as the basic idea for the successful processes which followed after his initial breakthrough.

## VIII.

Volpertas was associated with Faitelowitz in France. Volpertas determined that the initial drying stage of the Faitelowitz process could be accomplished merely by adding some of the fully dried product to the *moist* cooked potatoes and allowing absorption to take place to reduce the moisture content of the entire mixture by averaging or equalizing the moisture. When the moisture content equalized, *the mixture* could then be *finally* dried by the application of heat. The risk of *cell rupture and of case-hardening* was substantially decreased because *the cutting of the cooked potatoes into small pieces was eliminated* and the drying by heat during the first stage of the process *could be modified or shortened*, making the entire process more economical, less difficult to perform and more certain to produce an acceptable product *than Faitelowitz.* Volpertas' improvement on the Faitelowitz process is referred to as the add-back method or step. Add-back is old in the art of dehydration,

of food (including potatoes) and the art of starch-drying, but Volpertas was the first to apply it to a process for making an instant mashed potato powder. Volpertas, whose name is now Zelman Volpert, applied for a patent in Great Britain on October 14, 1937. This became British Patent 496,423, and serves as part of the basis for his United States Patent in suit. Volpertas also obtained French Patent 842,651 in March, 1939, and this also serves as another part of the basis of the [99 R 100] Volpertas United States Patent in suit.

## IX.

Rivoche was associated with both Faitelowitz and Volpertas in France. Rivoche claims credit for an improvement which prescribes limitations within which the Volpertas add-back process can always be successfully performed. Volpertas, in his earlier applications and foreign patents, taught the use of the add-back step in the first drying stage and also that the first drying stage could be continued until the potatoes showed " \* \* \* a loss in weight of 40 to 50% relatively to that of the initial material; in certain cases, said loss can even attain 60%." Rivoche in his United States Patent in suit teaches employing the add-back step until the mixture of wet vegetable and powder contains not more than "about 50% moisture." The various Faitelowitz, Volpertas, and Rivoche patents each suggest that when the initial drying stage is conducted to some point at which the cooked vegetable has a moisture content both above and below 50% the then moist powder can be dried by heat without substantial risk of cell rupture or of hardening. The British applications which are claimed as the basis for Rivoche's United States Patent were filed on September 16, 1939, and on December 15, 1939. The Rivoche patent in suit and these 1939 British applications disclose various processes for drying foods. Faitelowitz' United States Patent, Volpertas' French Patent 842,651, and Volpertas' British Patent 496,423 were all published prior to September 16, 1939, and are thus among the prior art as regards Rivoche.

[99 R 101] *Templeton*, for several years prior to 1939, had been interested in the vegetable drying industry and had made studies in Europe to determine if a successful process for manufacturing an instant mashed potato powder had been discovered. Rivoche was the first to show him an acceptable product and to disclose a feasible process for making the same. A year later Templeton obtained exclusive licenses to the processes in question in behalf of Farmers' Marketing & Supply Company, plaintiff's predecessor. During World War II an instant mashed potato drying industry arose in Great Britain based upon these same or similar processes.

## XI.

Meanwhile, in the United States the defendant was engaged in fruitless efforts to discover or obtain a successful process to fill the needs of our government. Defendant met with no success despite the fact that it had adequate facilities, finances, and skilled men in the art. Its expert witness, Ray W. Kueneman, had been employed by the Department of Agriculture during World War II. He had visited dehydration plants abroad to gather information for our government, and had seen and made diagrams of plant operations in Great Britain which were using processes similar to the ones in suit. After the war the defendant employed his services, but for the next five years a successful process still eluded it. Templeton visited the United States in 1945 and became acquainted with defendant's efforts. Defendant's officers professed an interest in plaintiff's processes; however, at this time plaintiff had not perfected its rights thereto in this country.

## XII.

[99 R 102] Templeton returned to the United States in 1949. Having acquired to his satisfaction the exclusive rights to the *Volpertas and Rivoche processes wherever patented*, he made another visit to the State of Idaho in *March, 1949*, to confer with the officials of the defendant company. They expressed *some* interest in joining forces to develop

*an instant mashed potato* product in this country. On March 4, 1949, Templeton conducted a *laboratory* demonstration at the defendant's plant in Caldwell, Idaho, during which he disclosed what he considered to be the basic teachings of the patents in suit. The record discloses that defendant was highly impressed by, and interested in, the processes. On March 8, 1949, Templeton submitted a written summary of what he considered to be said teachings and a written recommendation to defendant based on the *Faitelowitz* process. The parties orally reached an informal understanding in March, 1949, in regard to developing a *commercial process* (and the industry) in this country, which was to be formalized later, subject to the approval of their respective legal counsel. The terms of said agreement were left to future negotiations which, as events transpired, were very extended, and the parties ultimately failed to reach an understanding. The nature and extent of their dealings are more pertinent to plaintiff's contract action. While said negotiations were being *terminated*, the Korean War occurred and defendant went into production to help fill the military needs of our government, *and at that time defendant adopted some of the teachings of said patents for its own operations.*

### XIII.

[99 R 103] The parties are in substantial agreement on what defendant's process is, and has been, since it began production. Its process is *described in Plaintiff's Exhibit No. 5* and illustrated by Plaintiff's Exhibits No. 6 and No. 14, each of which was thoroughly explained by witness Ray W. Kueneman, director of Research and Development for the food processing division of the defendant company. It uses the *Faitelowitz* two-stage drying principle, but instead of drying by heat in the first stage as *Faitelowitz* teaches, defendant uses the *add-back step during its first stage drying (and prior to or during that stage mashes the cooked potato without added heat either by mashing rools or pug mills; when pug mills are used defendant simultaneously mashes and mixes)*. By this method, defendant has always reduced the moisture content of *its* mixture to between 30 and 40 percent before beginning the



second drying stage. Defendant conducts *its* second drying stage by means of a stream of hot air, using dryers which operate under a slightly sub-atmospheric pressure. *Defendant's drying systems reduce* the moisture content of the mixture to approximately 12 to 14 percent in this second drying stage. Thereafter, the *dried* powder is sifted *to separate the powder into coarse, fines and product, and part of the product fraction is* put through another system which reduces it to a finished product containing not more than about 6 to 7 percent moisture.

#### XIV.

Plaintiff contends that what takes place in defendant's [99 R 104] process after the sifting step is not relevant to the question of infringement (Tr. 117), and defendant does not quarrel with this contention. Defendant does not contend that the various apparatus used in its process from time to time or the minor changes made in the steps of the process in any manner changed the basic nature thereof, and the Court finds such to be the facts.

#### XV.

The Court finds that the Faitelowitz and Volpertas patents in suit are most susceptible of disposition on the ground of noninfringement, for defendant's process clearly does not infringe any of the claims of either of said patents.

#### XVI.

Plaintiff accuses defendant of infringement of claims 1, 2, 4, 5, 6, 7 and 8 of the Faitelowitz patent. These claims are accurately set forth in Plaintiff's Exhibit No. 1. Although the claims of a patent are the sole measure of the grant and the means by which infringement is to be determined, plaintiff did not attempt to make any comparison, between the accused process and the claims in suit, at the trial or in plaintiff's written briefs. This oversight is justified only by the fact that no significant comparison exists. Each of the claims of the Faitelowitz patent, other than claim 1, is dependent on claim 1 thereof. Each of the claims

in suit covers a process in which the all-important initial drying stage is performed on small cut pieces of cooked vegetable and is accomplished by means of heat which must not substantially exceed 100 degrees C. In comparing defendant's process with the Faitelowitz claims, it is obvious that defendant accomplishes the predrying stage by using the add-back method which does not involve, and is contrary to, the method employed [99 R 105] by Faitelowitz. Add-back is the later improvement attributed to Volpertas and is not suggested by Faitelowitz. Plaintiff urges that the doctrine of equivalents is applicable, but did not attempt to apply the doctrine at the trial or in written briefs. The Faitelowitz claims cannot be construed by any reasonable application of said doctrine to cover the defendant's process. The existing evidence clearly supports a finding of noninfringement with respect to each and every claim of the Faitelowitz patent in suit, and the Court so finds.

## XVII.

Plaintiff's main contention is that the defendant's process utilizes the Faitelowitz principle and thus infringes the patent. According to plaintiff's expert witness, Templeton, this principle is that: "the potato cells, within which are enclosed the starch grains, may, after cooking, be separated without injury to the membrane of the cells after a partial drying and before final drying." (Tr. 204). In the first instance, it has been recognized that one cannot patent a principle. Secondly, the evidence convincingly demonstrates that Faitelowitz did not disclose a practical process for putting that principle to use. Templeton admits that the Faitelowitz process has never been used for a commercial operation anywhere in the world. It took the add-back suggestion of Volpertas to put the so-called Faitelowitz principle into actual operation, and this departure from the Faitelowitz process is a distinguishing feature of most of the processes used in the industry, including defendant's process. The plaintiff has failed to sustain its burden of proving that defendant's process infringes any of the claims of the Faitelowitz patent.

**XVIII.**

[99 R 106] Plaintiff accuses defendant of infringement of claims 3 and 7 of the Volpertas patent, which claims read as follows:

"3. The process of preparing potatoes in powdered form, which includes all of the constituent elements of the potato other than water and which is capable of being converted into mashed potatoes by the simple addition of hot liquid, which process consists in cooking potato pieces in an environment of steam at a temperature of substantially 100 degrees C., thereupon pre-drying the potato pieces in the absence of mechanical pressure thereon until the initial weight of the potato mass has been reduced by about one-half due to the loss of water, cooling the potato mass to a temperature in the order of 10 degrees C. and mechanically converting the same into a moist powder and finally drying the moist powder under moderate heat and vigorous stirring in vacuo, until the water content of the powdered potatoes is down to about 12 to 15 percent.

"7. The process of preparing potatoes in powdered form, which includes all of the constituent elements of the potato other than water and which is capable of being converted into mashed potatoes by the simple addition of hot liquid, which process consists in cooking potato pieces in an environment of steam at a temperature of substantially 100 degrees C., thereupon pre-drying the potato pieces in the absence of mechanical pressure thereon until the initial weight of the potato mass has been reduced by about one-half due to the loss of water, cooling the potato mass, mechanically converting the same into a moist powder, drying the moist powder under moderate heat and stirring in vacuo until the water content of the powdered potatoes is down to about 12 to 15 percent, collecting the potato powder thus prepared to a substantial bulk and continuing the heating thereof until the water content is reduced to between 6 and 10 percent." (Plaintiff's Exhibit No. 2).

**XIX.**

[99 R 107] Volpertas' alleged contribution in the art of processing an instant mashed potato powder is set forth on page 12 of Plaintiff's Main Brief After Trial. There plaintiff states:

"That inventive concept of the Volpert patent *with which we are now concerned* resides in the discovery that the first stage of drying the cooked potato can be accomplished and the moist powder for the second stage simultaneously produced simply by adding to and gently and thoroughly mixing with, the cooked potato a sufficient quantity of previously fully-dried powder product. This process permits reducing the water content of the cooked potato mass in an economically practical way and without risk of hardening or scorching in the first drying stage." (Emphasis added.)

This alleged discovery attributed by plaintiff to Volpertas is an add-back method or step, and add-back is admittedly used by the defendant in its process.

## XX.

Section 112, Title 35, U.S.C.A., of the Patent Laws of the United States, and its predecessor, compel an applicant for a patent to conclude his application with "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention" after *first* having set forth in the specification the "best mode contemplated by the inventor of carrying out his invention." Neither of the claims 3 and 7 of the Volpertas patent points out nor distinctly claims the add-back method. Said claims refer only to "pre-drying the potato pieces in the absence of mechanical pressure" to reduce the moisture content of the cooked potato pieces in the first stage of the process. Other than this, the [99 R 108] method used to accomplish pre-drying is not specified in the claims in suit. Resorting to the specifications which are supposed to show the inventor's best mode for carrying out his process, the Court finds that the Volpertas pre-drying is to be accomplished by heat. This method is referred to on several occasions in the patent. Thereafter, Volpertas explains that if his process, using heat for pre-drying, is carried on in an ideal manner, no coarse particles should appear in the potato powder. However, he elaborates, that if there are some coarse particles, the same may be reclaimed by softening them by the add-back method. Then it is stated that: "In commercial practice, the result set forth in the previous paragraph" (reclaiming the coarse particles by add-back) "may be attained in continuous operation" and he

goes on to illustrate such reclaiming by add-back. (Plaintiff's Exhibit No. 2). In view of this disclosure in the specification, plaintiff argues that claims 3 and 7 include the add-back method or step and that defendant's process is equivalent to said claims in all respects. However, it should be noted that Volpertas *specifically* claimed an add-back step in claims 5 and 8 of his patent which claims are *not* in suit. In claims 5 and 8 said step is used at other stages in the process, and not for the purpose of pre-drying the cooked potato pieces in the first instance.

### XXI.

The Court believes that the reason Volpertas did not expressly claim the add-back method for accomplishing pre-drying in the claims in suit is quite obvious from an examination of the patent's file wrapper history. Defendant urges that said examination be made to support its contention that plaintiff is estopped from including the add-back method in claims 3 and 7 on the ground of [99 R 109] file wrapper estoppel. The evidence supports the finding of file wrapper estoppel against Volpertas and plaintiff with respect to each of his claims 3 and 7 in suit.

### XXII.

The file wrapper of the Volpertas patent is somewhat lengthy. As the patent states, it is a continuation, in part, of two copending applications. The most pertinent copending application is Serial Number 254,739, which was filed on February 4, 1939, in which Volpertas sought to obtain a patent based on a French application (which became French Patent 342,651 in March 1939). In this earlier copending United States application Volpertas attempted to claim a process wherein the vegetables were dried by the add-back method, but the examiner finally rejected such claims in view of prior patents which the examiner concluded covered such a method. Volpertas appealed on July 1, 1941. The application was later vested in the Alien Property Custodian and the appeal was dismissed on June 12, 1943. The application which became the Volpertas patent in suit was first filed on January 1, 1942, which the file wrapper

discloses was approximately the same time the add-back method claims of said earlier copending application were finally rejected by the examiner and on appeal. (Plaintiff's Exhibit No. 2, File History 3.)

### XXIII.

Under the circumstances set forth in paragraph XXII, above, the Court finds that Volpertas abandoned his claims to the add-back method for the different process covered by the claims in suit. The [99 R 110] evidence reveals that he abandoned add-back because his experience with his prior copending application taught him that such a claim would be rejected in view of prior patents. The method which Volpertas did claim, in his patent in suit, is pre-drying the cooked potato pieces by the first stage of his operation by the use of heat which is plainly disclosed by his specification. The Volpertas method covered in the claims in suit cannot be construed to be in any manner equivalent to the add-back method as used by the defendant. Accordingly, the Court finds that the defendant has clearly not infringed claims 3 and 7 of the Volpertas patent.

### XXIV.

The Volpertas process covered in the claims in suit and defendant's process are also materially different in other respects such as in the extent of cooling but, in view of the above, a discussion of these distinguishing features would be academic.

### XXV.

In considering the issues raised by plaintiff's patent infringement suit the usual practice is to determine the question of the validity of the patent before passing on the question of infringement. However, it appears that there is an exception to this rule where noninfringement is clearly apparent and the public interest does not require a holding of invalidity. Under such circumstances, which are here present with regard to the Faitelowitz and Volpertas patents in suit, the issue of validity is considered academic as, of course, are the other defenses raised by the defendant with respect to the said two patents. It is

not necessary to pass on the validity of either of the now expired Faite-lowitz or Volpertas patents in suit.

## XXVI.

[99 R 111] The Rivoche patent was applied for on January 27, 1948, and was granted on August 29, 1950; it expired on September 16, 1959. It claims priority based on two applications which were filed in Great Britain on September 16, 1939, and on December 15, 1939, and which became British Patents in 1948. It received the benefits of Public Law 690 (the Boykin Act) which extended the time for filing his United States application. The two claims in suit were inserted in the Rivoche application by amendment on June 28, 1950 (Plaintiff's Exhibit 3 (2) ); the claims read as follows:

"16. The method of preparing cooked starch vegetable foodstuff, in readily-reconstitutable form, from a mass of the cooked vegetable, which comprises performing successively and in the order set forth, the steps of thoroughly mixing the same with the same kind of dried and powdered vegetable foodstuff in amount to produce a resultant mixture containing not more than about 50% by weight of moisture, and drying said resultant mixture to form the readily-reconstitutable product, said drying operation being carried out so as to preserve substantially the structure of the vegetable solids, including capillary properties thereof.

"17. The method of claim 16 in which said resultant mixture is subjected to a sieving operation to disintegrate it into relatively small particles before it is subjected to the final drying operation." (Plaintiff's Exhibit No. 3).

## XXVII.

Although the claims 16 and 17 in suit clearly set forth the add-back method or step, plaintiff admits, and the Court finds, that Rivoche did not invent the add-back method. His contribution to the art of processing a dehydrated vegetable product is stated on page 13 [99 R 112] of Plaintiff's Main Brief After Trial wherein it is said:

"The only one Rivoche's contribution (sic) to the art that is presented for adjudication here can be simply stated as accurately prescribing a limitation within which Volpert's discovery can always be successfully performed. Rivoche determined that the Volpert's procedure for producing a moist powder for final drying would invariably succeed if the mix of cooked potato and dry product was brought to a total moisture content not exceeding 50% by weight at the time of reduction to the moist powder."

Hence, the crucial portion of each of the claims 16 and 17 is:

" \* \* \* the steps of thoroughly mixing the same with the same kind of dried and powdered vegetable foodstuff in amount to produce a resultant mixture containing not more than about 50% by weight of moisture, \* \* \* ."

The Rivoche patent in suit reveals that he considered the said "*about 50%*" moisture content to be an important feature in his process as a maximum moisture content. At this point, or at some point below "*about 50%*," the first drying stage ends and the second drying stage begins. The Rivoche patent teaches that the maximum point of about 50% moisture may be reached by several methods, including the add-back method. The difference between Rivoche's claimed improvement and the prior art is quite subtle, but the evidence supports the conclusion that his improvement does insure a more successful result. However, because of the slight degree of improvement over the prior art, the paramount question for determination is whether his improvement rises to the dignity of invention.

### XXVIII.

The evidence reveals that Rivoche's contribution to the art of processing an instant mashed potato covered in claims 16 and 17 added very little, if anything, to the known art. Defendant cites several foreign and United States prior patents in addition to those [99 R 113] of Volpertas and Faitelowitz to support its contentions that Rivoche contributed nothing which could be called an invention. However, said patents concern processes for making products other than mashed potato powder. The most pertinent prior art is that disclosed by the patents of



Faitelowitz and Volpertas. These patents show that Rivoche was not the first to determine a probable point of departure between the first and second stage drying operations. Faitelowitz teaches that the cooked potatoes should be first dried until they have "lost at the most about 60% by weight of their initial water-content." Volpertas said, "until the initial weight of the potato mass has been reduced by about one-half due to the loss of water." Rivoche's alleged improvement is the direction to dry the potatoes down to the point where they contain "not more than about 50% moisture." The Court believes that Faitelowitz' teaching might exclude experimentation beyond the point stated, but that Volpertas suggests experimentation in order to find the optimum point of departure between the two drying stages. Rivoche does nothing more than teach a minimum point of departure, leaving the optimum for experimentation. The defendant has been able to obtain an acceptable product by drying the cooked potatoes down to the percentages specified by all of the patents, but has, as the Court believes one skilled in the art would have, experimented to find the optimum point of departure as is suggested by Volpertas. Therefore, the Court is of the opinion that Rivoche's alleged improvement over Volpertas, is as contended by defendant, not inventive.

#### **XXIX.**

The Court finds that claims 16 and 17 of the Rivoche patent [99 R 114] in suit are each non-inventive and invalid. Under these circumstances, the issue of infringement of said claims for other reasons is academic as are the other defenses urged by the defendant.

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## STATUTES INVOLVED

### PART IV. — JURISDICTION AND VENUE

#### CHAPTER 83. — COURTS OF APPEALS

**28 U. S. C. 1291. Final decisions of district courts.** The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. (June 25, 1948, ch. 646, 62 Stat. 929; Oct. 31, 1951, ch. 655, sec. 48, 65 Stat. 726; July 7, 1958, Pub. L. 85 — 508, sec. 12(e), 72 Stat. 348.)

**28 U. S. C. 1292. Interlocutory decisions.** (a) The courts of appeals shall have jurisdiction of appeals from:

\*                         \*                         \*

(4) Judgments in civil actions for patent infringement which are final except for accounting . . . (June 25, 1948, ch. 646, 62 Stat. 929; Oct. 31, 1951, ch. 655, sec. 49, 65 Stat. 727; July 7, 1958, Pub. L. 85—508, sec. 12(e), 72 Stat. 348; Sept. 2, 1958, Pub. L. 85—919, 72 Stat. 1770.)

#### CHAPTER 85. — DISTRICT COURTS; JURISDICTION

**28 U. S. C. 1338. Patents, copyrights, trade-marks and unfair competition.** (a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

\*                         \*                         \*

(June 25, 1948, ch. 646, 62 Stat. 931.)

#### CHAPTER 87.— DISTRICT COURTS; VENUE

**28 U. S. C. 1400. Patents and copyrights.** (a) (Copyrights). (b) Any civil action for patent infringement may be brought in the judicial

district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business. (June 25, 1948, ch. 646, 62 Stat. 936.)

## CHAPTER 91.-- COURT OF CLAIMS

**28 U. S. C. 1498. Patent cases.** (a) Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for recovery of his reasonable and entire compensation for such use and manufacture.

For the purposes of this section, the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States.

\* \* \*

(c) The provisions of this section shall not apply to any claim arising in a foreign country. (June 25, 1948, ch. 646, 62 Stat. 941; May 24, 1949, ch. 139, sec. 87, 63 Stat. 102; Oct 31, 1951, ch. 655, sec. 50(c), 65 Stat. 727; July 17, 1952, ch. 930, 66 Stat. 757; Sept. 8, 1960, Pub. L. 86-726, 74 Stat. 855.)

## 35 U. S. C.

### CHAPTER 10--PATENTABILITY OF INVENTIONS

Sec.

- 100. Definitions.
- 101. Inventions patentable.
- 102. Conditions for patentability; novelty and loss of right to patent.
- 103. Conditions for patentability; non-obvious subject matter.
- 104. Invention made abroad.

#### § 100. Definitions

When used in this title unless the context otherwise indicates --

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### **§ 101. Inventions patentable**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

### **§ 102. Conditions for patentability; novelty and loss of right to patent**

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made

in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Notes — Section 4(b) of the Act of July 19, 1952 provides:

"Section 102(d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications."

Section 4(d) of the Act of July 19, 1952 provides:

"The period of one year specified in section 102(b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year."

### **§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### **§ 104. Invention made abroad**

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

## § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

## § 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

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Note — Section 4(c) of the Act of July 19, 1952 provides that the second paragraph of section 119 shall not apply in the case of patents existing on January 1, 1953.

Note. — See pages 68-74 for statutes temporarily extending the period of priority.

Note. — Following is a list of countries with respect to which the right of priority referred to in this section has been recognized. The authority in the case of these countries is the International Convention for the Protection of Industrial Property (613 O.G. 23, 53 Stat. 1748), indicated by the letter I following the name of the country; the Inter-American Convention relating to Inventions, Patents, Designs and Industrial Models, signed at Buenos Aires August 20, 1910 (207 O.G. 935, 30 Stat. 1811), indicated by the letter P after the name of the country; or reciprocal legislation in the particular country, indicated by the letter L following the name of the country. \* \* \* France (I), \* \* \* Great Britain (I), \* \* \*

### **§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

### **§ 132. Notice of rejection; reexamination**

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commission shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

### **§ 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six

months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### **§ 134. Appeal to the Board of Appeals**

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

### **§ 281. Remedy for infringement of patent**

A patentee shall have remedy by civil action for infringement of his patent.

### **§ 282. Presumption of validity; defenses**

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

- (1) Noninfringement, absence of liability for infringement, or unenforceability,
- (2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,
- (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,
- (4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such



notice proof of the said matters may not be made at the trial except on such terms as the court requires.

35 U. S. C. §§ 101-108, 110-114 (1946 Edition)

**1. Special Provisions for Conditions Arising from World War II: (Boykin Act).** An Act To extend temporarily the time for filing applications for patents, for taking action in the United States Patent Office with respect thereto, for preventing proof of acts abroad with respect to the making of an invention, and for other purposes. (Public Law 690, 79th Cong., 2d sess., ch. 910, approved Aug. 8, 1946; 60 Stat. 940.)

SECTION 1. The rights of priority provided by section 4887 of the Revised Statutes (U. S. C., title 35, sec. 32), as amended, for the filing of applications for patent for inventions, discoveries, and designs, which rights had not expired on the 8th day of September 1939, or which rights have arisen since the 8th day of September 1939, shall be, and the same are hereby, extended until the expiration of a period of twelve months from the passage of this Act in favor of the citizens of the United States and of citizens or subjects of all countries which have extended, or which now extend or which within said period of twelve months, shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications now pending or filed within the period specified herein: *Provided*, That no such extension shall apply to any patent unless a request in writing was made therefor during the pendency of the application for such patent in the United States Patent Office, or within twelve months after the passage of this Act, which request must be accompanied by (1) a copy of the original foreign application, certified to by the patent office of the country in which it was filed, but if the original foreign application has been destroyed, other evidence pertaining thereto may be accepted; (2) a sworn translation of the same if it is not in the English language; and (3) if the foreign application was not made by the inventor himself, an affidavit by the applicant or patentee stating that such application was filed for his benefit or on his behalf and that such procedure is in accordance with the procedure in the foreign country: *Provided further*, That no patent granted or validated by reason of any such extension shall in any way furnish a basis of claim against the Government of the United States: *Provided further*, That such extension

shall in no way abridge or otherwise affect the right of the United States, or of any person, firm, association, company, or corporation, who, before the passage of this Act was bona fide in possession of any rights in or under patents or applications for patents conflicting with rights in patents granted or validated by reason of such extensions to exercise such rights by itself or himself personally, or by such agents, or licensees as derived their rights from it or him before the passage of this Act, to the extent that they shall not be amenable to any action for infringement of any patent granted or validated by reason of such extension.

A patent shall not be refused on an application coming within the provisions of this section, nor shall a patent granted on such application be held invalid, by reason of the invention having been patented or described in any printed publication or in public use or on sale in the United States more than one year prior to the filing of the application in the United States, unless such patent or publication or such public use or sale was prior to the filing of the foreign application upon which the right of priority is based.

SEC. 2. Whenever, prior to the 8th day of April 1946, an invention, discovery, or a design has been communicated in writing or embodied in any article supplied to the Government of the United States or to any person, firm, or corporation in the United States at the request of said Government, pursuant to and by reason of an agreement or arrangement between the Government of the United States and the government of a foreign country for the supply or mutual exchange of information or articles for use for national defense purposes during the periods of the national emergencies declared by the President of the United States preceding World War II, or for use for war purposes during World War II —

(a) A patent based on an application filed by the inventor of the invention, discovery, or design so communicated or supplied shall not be refused or held invalid merely because of the fact that the invention, discovery, or design had been in public use or on sale in the United States, or described in a printed publication, if such public use or sale or publication was in consequence of and attributable to the communication or supply and subsequent to the date of the communication or supply; and

(b) For use in any action in a United States court or proceeding in the Patent Office involving a patent for an invention, discovery, or a design, or involving an application for patent for an invention, discovery, or a design so communicated or supplied any court of the United States for any district or Territory thereof,

and the Commissioner of Patents shall have the power to call upon any department or agency of the Government of the United States to produce information or papers in its possession relating to the communication or supply or relating to the further communication of the invention, discovery, or design by said department or agency to any person, firm, or corporation in the United States: *Provided, however,* That the head of any department or agency may refuse and omit to comply with any call for information or papers when in his opinion such compliance would jeopardize the national defense.

No benefit under section 2 of this Act shall be extended to any person unless (1) an application for patent for the same invention, discovery, or design which was communicated or supplied as aforesaid is filed in the United States Patent Office prior to the expiration of twelve months from the date of this Act; and (2) unless sufficient information in writing and under oath as to what was communicated or supplied, the date thereof and to whom made, is furnished to the Commissioner of Patents by the owner of such application while it is pending, or prior to the expiration of twelve months from the date of this Act to enable him to judge of the identity of the invention so communicated or supplied with the invention claimed in such application, which information shall be made a part of the record of such application and shall have no evidentiary value as proof of the facts stated therein; and (3) unless the country of which such person is a national extends substantially reciprocal privileges to citizens of the United States.

SEC. 3. That whenever it shall be shown to the satisfaction of the Commissioner of Patents that the time now fixed by law for the payment of any fee, or for the taking of any other action, with respect to an application for patent for an invention, discovery, or design has lapsed because of conditions growing out of World War II, which time had not expired on the 8th day of September 1939, or which commenced after the 8th day of September 1939, such time may be extended by the Commissioner to a date not later than twelve months after the passage of the Act, without the payment of extension fees or other penalty, in favor of citizens of the United States and the citizens or subjects of countries which have extended, now extend, or shall extend prior to the expiration of twelve months after the passage of this Act substantially reciprocal privileges to citizens of the United States: *Provided,* That no extension herein shall confer such privileges upon the citizens or subjects of a foreign country for a longer term than the term

during which such privileges are conferred by such foreign country upon the citizens of the United States, but nothing in this Act shall give any right to reopen interference proceedings where final hearing before the Examiner of Interferences or the Board of Interference Examiners has taken place.

SEC. 4. That no patent granted or validated by reason of any extension of time provided for by sections 1 and 3 of this Act shall abridge or otherwise affect the right of the United States, or of any person, firm, association, company, or corporation, or agent or agents, or his successor in business, to continue or to resume any manufacture, use, or sale bona fide commenced by it or him in the United States before the passage of this Act, or, in the case of an application claiming the benefits of section 3 hereof, commenced by it or him before the taking of action or the payment of any fee under that section if such action or payment was later than the passage of this Act, nor shall the further manufacture, use, or sale by it or him, or its or his agents or successors in business or the use or sale of the devices resulting from such manufacture or use constitute an infringement: *Provided*, That the benefits of this section shall not apply to the manufacture, use, or sale as aforesaid if and to the extent that it is based upon or attributable to a communication of the invention, discovery, or design so manufactured, used, or sold to the United States or to any person, firm, or corporation in the United States at the request of said Government under an agreement or arrangement between the Government of the United States and the government of another country for the supply or mutual exchange of information or articles for use for national defense purposes during the periods of the national emergencies declared by the President of the United States preceding World War II, or for use for war purposes during World War II.

SEC. 10. No patent for an invention or a discovery granted under the provisions of section 1 or 3 of this Act shall extend for a longer term than twenty years from the filing date of the first application regularly filed in any country disclosing the same invention, and in no event for a period in excess of seventeen years from the date of the grant of such patent.

SEC. 11. No claims for patent infringement shall be made or action brought by or on behalf of or for the benefit of any country or a national of any country against which the United States has declared the existence of a state of war, in respect to any manufacture, use, or sale since September 8, 1939.

SEC. 12. That nothing in this Act shall affect any act which has been or shall be done by virtue of the special measures taken during World War II under legislative, executive, or administrative authority of the United States in regard to the rights of any enemy, or ally of an enemy, as defined by the Trading With the Enemy Act of October 6, 1917 (40 Stat. L. 411), as amended, in patents for inventions and designs.

SEC. 13. Section 10(a) of the said Trading With the Enemy Act, relating to the filing and prosecution of applications for patents and the registration of trademarks, prints, labels, and copyrights, by an enemy, or ally of an enemy, is hereby repealed.

SEC. 14. The benefits of this Act shall not extend in favor of inventions, applications, or patents made by or owned by citizens of any country with which the United States shall have been at war since the 8th day of September 1939. The Alien Property Custodian shall be entitled to the benefits of this Act.

SEC. 15. Nothing contained in this Act shall be effective to nullify any judicial finding upon the validity of any patent for an invention, discovery, or a design heretofore made by a court of competent jurisdiction.

SEC. 16. If any clause, sentence, paragraph, or part of this Act shall be adjudged by any court of competent jurisdiction to be invalid, such judgment shall not affect, impair, or invalidate the remainder thereof, but shall be confined in its operations to the clause, sentence, paragraph, or part thereof directly involved in the controversy in which such judgment shall have been rendered.

**2. Further Extension of Time for Taking Actions Permitted by Boykin Act.** An Act to extend temporarily the time for filing applications for patents and for taking action in the United States Patent Office with respect thereto. (Public Law 220, 80th Cong., 1st sess., ch. 302, approved July 23, 1947; 61 Stat. 413.)

The period of extension of priority rights under section 1 of Public Law 690, Seventy-ninth Congress, approved August 8, 1946, and the time for the payment of any fee or the taking of any other action under section 3 of said Act, specified as expiring twelve months after the passage of that Act, shall be further extended to a date not later than February 29, 1948, \* \* \*

## 35 U. S. C. § 109 (1946 Edition)

**§ 109. Establishment of invention by reference to knowledge or use in foreign country; priority rights**

In proceedings in the Patent Office and in the courts of the United States an applicant for a patent for an invention, discovery, or a design, or a patentee, shall not be permitted to establish the date of invention or discovery by reference to knowledge or use thereof, or other activity with respect thereto, in a country foreign to the United States, other than the filing in a foreign country of an application for a patent for the same invention, discovery, or design which, in accordance with the provisions of section 32 of this title or in accordance with and subject to the provisions of sections 101-114 of this title, is entitled to have the same force and effect as it would have had if filed in the United States on the date on which it was filed in such foreign country: Provided, That where an invention was made by a person, civil or military, during the time such person was domiciled in the United States or its possessions and was serving in a foreign country in connection with the prosecution of the war on behalf of the United States or its allies, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect to such invention as if the same had been made in the United States. Aug. 8, 1946, c. 910, § 9, 60 Stat. 943.

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**TABLES OF OLD AND NEW STATUTES**

1. Table showing where subject matter comparable to present Title 35 may be found in prior statutes.

<i>Present title 35 section</i>	<i>Old title 35 (1946 edition) section</i>	<i>Revised Statutes, section; or other law</i>
100 . . . . .	. . . . .	
101 . . . . .	31 . . . . .	R. S. 4886
102 . . . . .	31, 32, 72 . . . .	R. S. 4886, 4887, 4923
103 . . . . .	. . . . .	
104 . . . . .	72, 109 . . . . .	R. S. 4923, Act Aug. 8, 1946, ch. 910, sec. 9, 60 Stat. 943.

Present title 35 section	*	Old title 35 (1946 edition) section	*	Revised Statutes, section; or other law
112 . . . . .	*	33 . . . . .	*	R. S. 4888
119 . . . . .	*	32 . . . . .	*	R. S. 4887
120 . . . . .	*	. . . . .	*	
132 . . . . .	*	51 . . . . .	*	R. S. 4903
133 . . . . .	*	37 . . . . .	*	R. S. 4894
134 . . . . .	*	57 . . . . .	*	R. S. 4909
281 . . . . .	*	67, 70 . . . . .	*	R. S. 4919, 4921
282 . . . . .	*	69 . . . . .	*	R. S. 4920

2. Table showing where the subject matter of prior statutes will be found in new Title 35.

A. Revised Statutes of 1874

R. S. Sec.	*	35 U. S. C. Sec.	*	*
4886 . . . . .	*	101, 102, ***	*	*
4887 . . . . .	*	102 (d), 119 ***	*	*
4888 . . . . .	*	111, 112, ***	*	*
4894 . . . . .	*	133 ***	*	*
4903 . . . . .	*	132, 135	*	*
4909 . . . . .	*	134	*	*
4919 . . . . .	*	281, ***	*	*
4920 . . . . .	*	282	*	*
4921 . . . . .	*	281, ***	*	*
4923 . . . . .	*	102, 104	*	*

C. United States Code, Title 35, 1946 ed.

Old Title (1946 ed.) Sec.	New Title 35 Sec.
*	*           *
31 . . . . .	101, 102, ***
32 . . . . .	102 (d), 119, ***
33 . . . . .	111, ***
*	*           *
37 . . . . .	133
*	*           *
51 . . . . .	132, 135
52 . . . . .	135
*	*           *
57 . . . . .	134
*	*           *
67 . . . . .	281, 284
69 . . . . .	282
70 . . . . .	281, 283-6, 290
*	*           *
72 . . . . .	102, 104
*	*           *
109 . . . . .	104

Note. -- In the 1946 edition of the U. S. Code, section numbers 89-96 of title 35 were assigned to sections 1 to 8 of the Royalty Adjustment Act, see page 74; section numbers 101-108, 110-114 were assigned to sections 1-8, 10-12, 14, 15 of the Boykin Act, see pages 68-72; section numbers 115-118a were assigned to the Veterans Patent Extension Act, see page 74; the acts or sections of acts referred to are no longer included in title 35 and are not codified. Section 119 of the 1946 edition of title 35 is now section 2371 of the appendix to title 50, see page 66.



## LIST OF EXHIBITS

The list of exhibits in plaintiff's appendix pp. 15a to 17a of Main Brief contains enough errors to be misleading to This Court. The list of exhibits has been corrected and reproduced by Defendant with some explanatory notes. Defendant's index is also supplemented by an Index of Designated Documentary Exhibits as page-marked in red numbers for the convenience of This Court.

<u>Exhibit</u>	<u>Description</u>	<u>Offered (T)</u>	<u>Admitted (T)</u>
1	Faitelowitz Patent and Patent Office File History	10	11
2	Volpertas Patent and File History and File Histories of Abandoned Applications	15	16
3	Rivoche Patent and File History, and Rivoche British Applications	18	18
4	Abstract of Title to Patents	23	28 Q
5	Report and Journal Articles, Simplot Process	45	46
6	Chart	47	49 Q
7	Letter, Equipment List and Process Description	127	127
8	Correspondence	175	177 Q
9	Letter - 3/16/49	194	195
10	Handwritten Notes	195	196
11	Patents and Publications from Harrington and Olson Deposition	280	285 Q
12	Heated Paddle Mixer Drawing	368	368
13	Photographs (3) Steam Heated Dryer	368	368
14	Flow Sheet Simplot Processes	386 (?)	387 (?)
15	Agreements, Farmers Marketing	685	686
16	Assignments of Patents	690	691

LIST OF EXHIBITS--Continued

<u>Exhibit</u>	<u>Description</u>	<u>Offered (T)</u>	<u>Admitted (T)</u>
17	Patents and Other Prior Art	692	1026
18	Application	758	758
19a	Drawing of Heated Mixer	802	802
19b	Drawing of Heated Mixer	802	802
20	Royalty Adjustment Order	830	830
21	Chart, Chronology of Patents in Suit	885	886
22	Volpertas, Rivoche, Agreement Farmers Marketing	919	920
23	Assignment	943	943
24	Samples (2)	944	945 (?)
25	Microphotographs (4)	960	960
26	Combined Food Board Report (Kueneman), 1943	992	993 Q
27	Letter (4/10/43)	978	N. A.
28a	Sketch by Kueneman, 1943	982	983
28b	Sketch by Kueneman, 1943	982	983
28c	Sketch by Kueneman, 1943	982	983
29a-g	Kueneman Notes	1013	1013
30	Volpert Patent (foreign)	1020	1020
31	Rivoche Patent (foreign)	1020	1020
32	Book-Food Technology	1029	1030 Q
33	Correspondence	1047	1047 Q
34	Patents and Publications	1047	1048 Q
35	Draft Report	1053	1053
36	Draft Report	1053	1053
37	Draft Report	1053	1053
38	Charts (Dr. Jackson's)	1176	1177
39	Push Final Specimen	1358	1358
40	Pull Final Specimen	1358	1358

LIST OF EXHIBITS--Continued

<u>Exhibit</u>	<u>Description</u>	<u>Offered (T)</u>	<u>Admitted (T)</u>
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42	1951 Product	1358	1358
43	Simplot News	<i>1397</i>	1397
44	Patent Book	<i>1442</i>	<i>N. A.</i>
45	Assignment 12/8/59	1444	1445
46	Assignment 10/11/61	1444	1445
47a	Inter Partes Test Caldwell	1454	1454
47b	Photographs (21) of Caldwell Tests	1454	1454
48	Shelley Procedures	1475	1475
49a-e	Notes & Drawings (Glabe)	1487	1487 Q

Note: Where an exhibit was offered but excluded on objection the notation "N. A." has been used. Where the exhibit was admitted on a qualified basis the notation "Q" has been used. Where plaintiff's Index was in error italics have been used. Where an exhibit has apparently been offered and admitted but doubt exists the notation (?) has been used.

**I N D E X**  
**OF DOCUMENTARY EXHIBITS AS BOUND**  
**FOR CONVENIENCE OF THIS COURT**

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**I N D E X**  
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**THE FAITELOWITZ CLAIMS IN SUIT**

**See Over**

## THE FAITELOWITZ CLAIMS IN SUIT

"1. A method of reducing potatoes and other starch-containing vegetables to the form of a dry powder in which the starch is preserved in its initial form which comprises cooking the vegetables at a temperature which must not substantially exceed  $100^{\circ}\text{C}.$ , cutting the cooked vegetables into small pieces, partially drying the pieces, at a temperature which also must not substantially exceed  $100^{\circ}\text{C}.$ , until they have lost at the most about 60% by weight of their initial water-content, reducing the partially dried pieces to the form of a moist powder and further drying the moist powder, at a temperature which must not greatly exceed  $80^{\circ}\text{C}.$ , until it has a water-content of approximately 10-15% by weight."

2. A method as claimed in claim 1, in which the moist powder is continually agitated while it is being dried.

4. A method as claimed in claim 1, in which the partial drying of the pieces is such as to cause them to lose 50 to 60% in weight calculated on the weight of the raw vegetables.

5. A method as claimed in claim 1, in which the partially dried chopped vegetables are grated or crushed to produce the moist powder.

6. A method as claimed in claim 1, wherein the drying is carried out in stages.

7. A method as claimed in claim 1, wherein the drying is carried out in stages and under a reduced pressure.

8. A method as claimed in claim 1, wherein the drying is carried out under a reduced pressure.





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**THE VOLPERTAS CLAIMS IN SUIT**

**See Over**

## THE VOLPERTAS CLAIMS IN SUIT

"3. The process of preparing potatoes in powdered form, **which includes all of the constituent elements of the potato other than water** and which is capable of being converted into mashed potatoes by the simple addition of hot liquid, which **process consists** in cooking potato pieces in an environment of steam at a temperature of substantially 100 degrees C., **thereupon pre-drying the potato pieces in the absence of mechanical pressure thereon until the initial weight of the potato mass has been reduced by about one-half due to the loss of water,** cooling the potato mass to a temperature in the order of 10 degrees C. and **mechanically converting the same into a moist powder and finally drying the moist powder under moderate heat and vigorous stirring in vacuo,** until the water content of the powdered potatoes is down to about 12 to 15 per cent.

7. The process of preparing potatoes in powdered form, **which includes all of the constituent elements of the potato other than water** and which is capable of being converted into mashed potatoes by the simple addition of hot liquid, which **process consists** in cooking potato pieces in an environment of steam at a temperature of substantially 100 degrees C., **thereupon pre-drying the potato pieces in the absence of mechanical pressure thereon until the initial weight of the potato mass has been reduced by about one-half due to the loss of water,** cooling the potato mass, **mechanically converting the same into a moist powder, drying the moist powder under moderate heat and stirring in vacuo** until the water content of the powdered potatoes is down to about 12 to 15 per cent, **collecting the potato powder thus prepared to a substantial bulk and continuing the heating thereof until the water content is reduced to between 6 and 10 per cent."**







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**THE RIVOCHÉ CLAIMS IN SUIT**

**See Over**

## THE RIVOCHÉ CLAIMS IN SUIT

16. The method of preparing cooked starchy vegetable foodstuff, in readily-reconstitutable form, from a mass of the cooked vegetable, which comprises **performing successively and in the order set forth, the steps of thoroughly mixing the same** with the same kind of dried and powdered vegetable foodstuff in amount **to produce a resultant mixture** containing not more than about 50% by weight of moisture, **and drying said resultant mixture** to form the readily-reconstitutable product, **said drying operation being carried out so as to preserve substantially the structure of the vegetable solids, including capillary properties thereof.**

17. The method of claim 16 in which said resultant mixture is subjected to a sieving operation to disintegrate it into relatively small particles before it is subjected to the final drying operation.

REPRODUCTION, WITH ADDED EMPHASIS,  
OF TEMPLETON'S 1949 PROPOSALS  
(DX 8, III-pages 47 to 58, incl.)

EXPLANATION OF U.S.A. PATENT POSITION

1. The first man to find out and teach that cooked potato may be divided to the form of a damp powder after reduction of its water content by 50% of the original weight was **ARNOLD FAITELOWITZ**.

Faitelowitz worked at a laboratory in Paris. He had devoted himself for many years to this problem which had defeated the best brains of the vegetable drying industry for half a century. Upon finding the solution above mentioned, he described it in Document No. 822795 granted as a patent in France on the 7th January, 1938 on application dated 8th June, 1937. This is the first record as far as the writer is aware anywhere in the world which fairly and clearly describes the prerequisite condition which Faitelowitz discovered as the means of making a powder out of potatoes in which the cells individually or in small clusters can be rendered in a substantially undamaged condition and therefore be capable of reconstitution into mashed potatoes.

Since this date, there have been many applications for patents for the production of the same or similar product in France, United States and the United Kingdom but as far as the writer is aware, no other person in any of these countries is able to proceed at all without using the discovery first outlined by Faitelowitz.

Amongst these applicants are the Doctors Volpertas and Rivoche. These differ from the others in that in fact they were co-workers with Arnold Faitelowitz in the laboratory referred to at Paris and each of them made claim to have added to the work of Faitelowitz a significant and patentable improvement, e.g.

(a) **Volpertas** showed that by using the equivalent step of adding back the end product to the freshly boiled potatoes instead of preliminary drying by heat as suggested by Faitelowitz, the same result could be more easily obtained, that is to say, the mashed potato could be

separated into the prerequisite damp powder much more quickly and less expensively and thereafterwards Volpertas' process was substantially the same as Faitelowitz; in short, he proposed a quickening of the first stage of the process.

(b) Rivoche then showed a further improvement on Volpertas. In that the disadvantage of the latest contribution was the large amount of the end product which had to be reserved from sale in order to be available for re-mixture, Rivoche proposed improvement to avoid this disadvantage. He found and described that by cooling the cooked potato to the point of freezing, it then became possible to remove a substantial quantity of the water (as taught by Faitelowitz) by the alternative of mechanical means, e.g., centrifuge or pressure. By these means, Rivoche was able to reduce the water content without heat and without dry admixture and obtain the damp powder without the foregoing disadvantages and he proposed the use of dry admixture only as a supplementary step, as it were, for those occasions when the mechanical methods did not quite eliminate enough water for the final drying.

These three steps are described in the three American Documents No. 2119155, No. 352670 and No. 4533.

NOTE: For priority purposes, it must be appreciated that Faitelowitz dates from 1936, Volpertas from 1938 and Rivoche from 1939. Delay in their applications for grant in the U.S.A. was occasioned by war circumstances.

Dr. Rivoche is working on a further improvement which he hopes to protect in due course.

There are two other documents, No. 2381838 and No. 2439119, granted as U.S.A. letters patent to Theodore Rendle - Chivers & Company, England - and Arthur Willett and Theodore Rendle - M.P.P. Products, England respectively. These documents are dated August 7, 1945 and April 6, 1948, that is to say, several years subsequently to the dates of Faitelowitz, Volpertas and Rivoche.

The similarity of these subsequent grants, Rendle and Willett-Rendle, when compared with the original inventors' will be remarked. It is believed that the current production of mashed potato powder in the

U.S. by the R.T. French Company proceeds under license from the Rendle and Willett-Rendle grants and the F.M.S. Company believes that such manufacture infringes the art disclosed in their original documents in favour of Faitelowitz, Volpertas and Rivoche.

### COMMENTARY ON EXISTING PLANT

One or another of the processes within the patented range can be adapted to practically the whole of the plant which I saw at Caldwell and/or was described to me as available to be installed at Caldwell, having been extracted from other nearby factories.

For example, one or all of the tunnels could be used if need be. The large cyclone is ideal for the job of reducing the moisture from about 45% to about 20%. The Proctor-Swartz can serve equally well to reduce from normal moisture to 50-50 or being dressed in a cloth to close the perforations of its band, this machine will serve equally well from 20% to 10% or below. The centrifuges should be satisfactory in removing large quantities of water mechanically after freezing and the freezing apparatus seems capable of taking care of a very large capacity.

In a separate document, I have proposed an immediate commercial start upon a modest scale likely to yield a production of 30 tons per week, using the Proctor-Swartz followed by conditioning hoppers, followed by percussion grinding, followed by hot air conveyance, finished by rotary driers. For this purpose I have to exclude the large cyclone, the capacity of which is too high.

Subject to Mr. Kuhneman's further advice, I take the capacity of the large cyclone to be of the order of 1,500 pounds of moisture per hour when served with air at say 250-300 F. It follows that for the final stage of commercial operation, this machine is likely to fix the capacity of the plant leading up to it on the one hand and following from it on the other.

This means that if the damp powder entering the large cyclone is to be 45% of moisture and the offtake product is to be 20% of moisture and the machine is to work at capacity, say 1,500 pounds, then approximately 4,600 pound of damp powder at 45% moisture or 2,070 pounds moisture will be its "appetite"

more or less. Looking downwards, 4,600 pounds should convert through this cyclone to 3,100 pounds containing about 570 pounds of moisture which thereafter by flat drying or gentle rotaries must be reduced further by about 300/350 pounds moisture thereabout, a comparatively easy task capable of arrangement by one of several methods.

Looking in opposite direction, the feed or appetite of the cyclone at 4,600 pounds at 45% of moisture will require the elimination of 8,050 pounds of water (depending on the moisture content of the potatoes) by centrifuge or other mechanical means and it follows that the intake capacity of the plant will be of the order of 12,650 pounds cooked potato yielding 2,700 pounds dry solids or approximately 130/160 tons per week, depending on number of hours worked.

It is quite clear that the Caldwell factory with the accessories that are understood to be available is capable without further capital outlay for new machinery of turning out considerable quantities of mashed potato powder but as stated in the foregoing, it would be unwise to make a firm recommendation as to the nature, size and scope of the full scale commercial process until further information has been ascertained by laboratory studies as to the behaviour, flavour and colour of the Idaho potatoes which are to be the subject of the operation.

### PROPOSALS FOR IMMEDIATE LABORATORY WORK

1. On Friday, the 4th March, at Simplott laboratory, Caldwell, I demonstrated the production of mashed potato powder by each of the three general proposals thus:

- (i) Faitelowitz - two samples of differing particle size
- (ii) Volpertas - one sample
- (iii) Rivoche - two samples by two methods within his proposals

2. The conditions under which these samples were produced were not ideal and for the continuance of necessary laboratory work, two pieces of equipment are essential:-

1. A convenient laboratory scale drier for which I recommend the rotary type and have cabled F.M.S. London to forward drawings of their own laboratory drier.
2. A stronger centrifuge necessary to give more accurate data as to the quantity of water which may be expressed from Idaho potatoes after freezing with true guide as to the loss of solids therein.

I recommend these two pieces of plant be got as quickly as possible.

3. Such facilities being available, I recommend a series of further

tests:

(a) In accordance with the teaching of Faitelowitz, that is to say, drying down shreds of riced or broken pieces until they have lost 50% or at the most 60% of their initial weight, then equilibration (natural and cold) before final drying. These tests will establish more definitely whether any advantage is to be found by freezing after pre-drying. They will also establish a flavour-colour basis which should be the truest reflection of Idaho potatoes which can be obtained by any means within the patented range because in this case, there will be no dry re-usage and there will be no loss of solids by mechanical extraction.

(b) In accordance with the teachings of Volpertas:- The one test done last Friday served only to illustrate the ease and convenience of this method. I had to use English seed in the finished product which was produced and proportion was still high in relation to the addition of solids from Idaho potatoes. It will be wise to continue with the bulk sample which I left behind a series of further tests having as object the gradual elimination of the English seed so that you will finish with a product which is substantially 100% Idaho potato solids, and so be able to check colour and flavour of this method more accurately.

The same experiments should be adapted to enable you to draw a second broad conclusion, viz., as to what is the smallest proportion of dry admixture which can be added to the freshly boiled potato when applied to Idaho potatoes. I would expect that you will find that an admixture of one part to five parts by weight would be about the minimum at which you can go in the type of apparatus which you are likely to be using in your laboratory, viz., a rotary drier.

(c) In accordance with the teachings of Rivoche, I suggest that you develop further each of the two experimental approaches which were demonstrated on Friday. It was clear that the extraction of liquor after freezing by centrifuge and alternatively pressure, some of the colouring matter of the potato with other solubles came away with the water. The figure of 5.9 solids needs substantiation under conditions by which you will be able to apply centrifugal force much greater than that which was available on Friday and nearer to what you may expect to apply under commercial conditions. Although the samples which we produced indicated that the loss of flavour was not critical and the improvement in colour was marked, it is still desirable to establish these impressions much more firmly before we can contemplate commercial operation applied to Idaho potatoes by this particular process out of our range of processes.

### PROPOSALS FOR COMMERCIAL OPERATION

I reserve my views as to the best method of setting up substantial commercial operations to await the first stage of preliminary laboratory work which has been outlined in the previous document and before giving my final advice upon this matter, I shall require further direct discussion in the joint interests of both companies and having regard to the proposed undertaking by my company that the risks of infringement shall be assumed by my company.

However, after further discussion with Mr. Ray Kuhneman on Saturday last, I am satisfied that a quick start can be made upon one basis of commercial production which will meet Mr. Kuhneman's point of providing useful experience and alternative outlet during the period of government demand for potato flour and will meet Mr. Simplott's point that he wishes to be recognized as a producer and seller of mashed potato powder as quickly as possible.

To achieve these purposes, it must be accepted that no attempt at the moment will be made to sell the product produced domestically in packet, that sales would be limited to armed services or government departments in bulk, for which I understand order will be made available, and for experimental and limited transactions in the institutional market. The method by which goods can be produced practically forthwith on the plant which is available



**will have to follow the teaching of Faitelowitz** and I make the following proposals which I should add I am able to make only after the further discussion and with the helpful advice of Mr. Kuhneman.

1. Use the evaporating capacity of the Proctor-Swartz machine stated at 1,000 pounds per hour to reduce the cooked potato in the form of rice from 2,000 pounds to 1,000 pounds of take weight.

2. Since 2,000 pounds cooked riced potato will be at about 1,500 pounds water content, it follows that the offtake product will contain 500 pounds of water in association with 500 pounds of solids which conforms with the teaching of **Faitelowitz** practically exactly.

3. **Trial and error will show whether it is better to use a longer drying time with humidified air in Proctor-Swartz machine, so avoiding case hardening or whether it is better to use dry air in quicker drying time and to allow equilibration as the cure of case hardening immediately after the drying.** The ultimate result is of course the same. Of the two, I prefer the second.

4. Assuming the second course to have been adopted, it will be necessary to have at least two conditioning hoppers after Proctor-Swartz each having capacity for one or at the most two hours offtake of the machine, such hoppers to be fed and discharged alternatively and preferably to be banded with a cooling solution which will have the effect of adding equilibration and limiting tendencies towards off-flavour.

5. It will be sufficient to drop from hoppers (#4 above) to impact grinder and the cells should not suffer damage so long that the moisture content at that time between say 40 to 50% is reasonably evenly distributed throughout the riced particles and if a current of warm air is used in the conveyance of the ground damp powder to cyclone, it will be found that the requirement for final drying can be performed in 2/3 steam heated mixers of approximate dimensions 10 feet by 3 feet with any simple paddle device, the ends thereof clearing the sides by at least one sixteenth of one inch.

I think that a production of 500 pounds to 550 pounds mashed potato powder containing say 8% residual moisture can be secured promptly by the flow indicated above and in consequence it might well be possible having regard to Mr. Kuhneman's point and Mr. Simplot's policy to make and sell something better than thirty tons per week of the product, commencing promptly and I recommend this be done for the good reasons which both of these gentlemen have proposed,

leaving the wider and more vital issues of the final selection of commercial process for larger operation to follow in due course out of the laboratory work which has been formulated heretofore, and such selection would undoubtedly be greatly aided by the limited commercial practice which I accordingly recommend should be started as soon as possible.

## SALES POLICY

Of the various matters to which I have addressed myself and offered advice herewith, none is in my view of greater importance than the matter of sales policy.

The Heads of Agreement require acquiescence between us in three qualitative standards as controlling the issue of product for sale in the three main divisions of the anticipated total market. I wish to extend this provision by recommendations as follows:

- (a) **Bulk purchases by the armed services or departments of the Government.**

The standard here must be based at such a level as will give non-sticky mach of good appearance and good flavour which will be for the laboratories on both sides to agree but probably will not need to be quite so rigid as that for

- (b) **Bulk purchases by institutions,**

where the discrimination of second and third buying as opposed to trial order buying is generally found to be rather higher than in the case of (a) above and again by agreement between the laboratories on either side the specification of quality must allow for this factor.

- (c) **Domestic purchases by individual consumers (the packetted trade).**

In this case it is my view that the experience in the United Kingdom demonstrates adequately that the product produced satisfactorily and in very large quantity for markets (a) and (b) above has not been good enough to hold steady and reliable trade amongst the highly discriminating area of

domestic demand and I recommend that the laboratories on either side should defer any attempt to set up the requisite standards in this case until as a result of the laboratory work which is called for in separate document hereto, a much greater experience has been gathered as to the influence of our processes on flavour and appearance upon Idaho potatoes.

I do not see at the moment that the F.M.S. Company or its proposed subsidiary, F.M.S. (America) Inc., can assist the Simplott Company in the matter of sales of mashed powder in market (a) but I do think that in marketing (b) and especially in market (c), that the proposed subsidiary may be of very considerable help and whilst it is clearly in no one's interest that anything should be done to limit sales endeavor, I think it must be agreed that the fullest discussion and cooperation should take effect at all times in connection with marketing in these second and third channels.

I also recommend that F.M.S. (America) Inc., quite apart from and additional to the Simplott Company, should be active in the marketing sense and that having regard to the possibility of demand arising from the R. T. French Company which has been discussed with Mr. Simplott and having regard to the policy of F.M.S. (America) Inc., to become an active force in the job of marketing generally, it should be inherent in the understanding that the Simplott Company will supply (subject reasonable and proper notice) through F.M.S. (America) Inc., to the extent of reasonable and agreed tonnages in accordance with discussions which will require to take place from time to time.

A very wide experience of marketing has been accumulated in United Kingdom and elsewhere in regard to mash powder as well as other products. It is quite clear that success in the present development generally is more dependent upon the solution of marketing difficulties rather than production problems and these matters must be worked out between the parties who will arrange to meet regularly for that purpose.

